IN THE

Supreme Court of the United States,

October Term, 1919. No. 117.

MATTHEW T. CHAPMAN AND MARK C. CHAPMAN,

Petitioners,

v.

JOHN A. WINTROATH.

MEMORANDUM IN ANSWER TO BRIEF FILED, AMICUS CURIAE, BY MR. MELVILLE CHURCH.

May it please the Court, in reply to the brief filed "amicus curiae" by Mr. Church, counsel for Wintroath begs leave to submit this memorandum.

The statement of the issue here involved as given at the beginning of Mr. Church's brief is incorrect, and is based on a misconception as to the facts in the instant case. It treats the Chapman application as if it were a *new* case, while the fact is, it is not. It would have no standing whatever as such, on Chapman's own showing, but must be considered as a continuing application based on the original case in order to get the benefit of the early filing date.

The record shows the following facts: Wintroath filed his application December 2, 1912, and about a year later (November 25, 1913), he secured the issue of his patent having the claims here in controversy. He put the invention into commercial use. Over two years after he obtained his patent he received a declar-

ation of interference with Chapman & Chapman which, it developed, was based upon a case containing, among others, three claims which had been taken bodily from Wintroath's patent twenty months after its issue and publication, the Chapman application being filed, not as a new case, but as a division or continuation of an old application filed March 10, 1909, which, at the time of the declaration of interference, had been in the Patent Office seven years.

Examination of the file history of this old Chapman application discloses the fact that it contained some twenty-three figures showing various parts of an entire pumping apparatus largely relating to the pump runners, tubes, casings, and other parts not involved in this interference. The invention here in controversy happened to be illustrated in association with other parts in figure 12, but it appears in none of the other twenty-three figures. As the case was originally filed it contained some thirty-four claims covering a great variety of improvements, but no claim at all corresponding to the issues herein. (See Commissioner's Decision, Record, p. 73.)

By an amendment of April 21, 1911, one of the claims (Record, p. 101), was amended so as to be readable upon the subject matter shown in figure 12 without, however, involving the issue of the interference. In response to this amendment, on May 11, 1911, more than two years after the case was filed (Record, p. 103), the Patent Office notified Chapman that this claim, numbered 5 (Record, p. 103), was directed to subject matter shown in figure 12, and that such subject matter was examinable in another division, and division was "therefore required." In response to such action, on April 8, 1912, Chapman by amendment (Record, p. 104), canceled out the said claim, stating that he reserved the right to "file a separate application for the subject matter."

Nothing, however, was done with the subject matter of figure 12 until he filed his divisional application in which, for the first time, were introduced claims involving the issue of this interference certain of which were taken bodily from Wintroath's issued patent over *three* years after the cancellation, and over *four* years after he had been definitely advised by the Patent Office of the requirement of division, and then only after Wintroath's patent had been issued and published for twenty months, and after Wintroath had his apparatus in commercial use and, according to Chapman's own argument (see our Main Brief, p. 13), after he himself had had the invention in public use considerably more than two years.

The statute which must be primarily considered in ruling upon the above facts is clearly the one (section 4894) which outlines the duties and responsibilities of a party claiming rights under a pending or continuing application.

The Patent Office throughout has treated the Chapman divisional application as a continuation of the earlier case. That was in accordance with its established rules and precedents. Under well-settled practice a rule was entered against Wintroath to show cause within thirty days why judgment should not be rendered in favor of Chapman on his record date (see Record, pp. 56 and 57), even before Wintroath made his motion (Record, p. 62), sustained by the Court of Appeals, for judgment against Chapman based on Chapman's lack of diligence, working estoppel and abandonment of his application by failure to comply with the requirements of the statutes covering the prosecution of pending applications.

Section 4894 of the statute is as follows:

"All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in

> default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

Careful study of the above shows that it contains two parts or divisions, both directly applicable to the state of facts in the instant case.

In the first place it requires that, after filing an application, it "shall be completed and prepared for examination within one year after the filing of the application" or else the case will become "abandoned" unless the Commissioner of Patents shall be satisfied a longer delay was "unavoidable."

In the instant case the application as first filed, March 10, 1909, showed the invention in Fig. 12, but contained no claims to the subject matter in issue until six years afterward, when the divisional application was filed. Furthermore, in connection with a claim amended April 21, 1911, and numbered 5, which happened to be readable specifically upon this figure 12, the Patent Office said that it was examinable in a different division and "division is therefore required." But after this requirement and the subsequent cancellation of said claim, as above pointed out, nothing was done with respect to the subject matter of Fig. 12 until the filing of Chapman's divisional application *twenty* months after the issue of Wintroath's patent.

Thus, the application was not "perfected" in any respect as to said Fig. 12 until more than two years after it was filed, which clearly, under the precise language of section 4894, rendered the case as to such invention of Fig. 12 "abandoned."

The statutes, section 4888, require that an appli-

cant shall "~~partially~~ particularly point out and distinctly claim" the invention which he seeks to cover. An application without such claim is no more completed than it would be without an oath or with a defective specification or drawing which the Patent Office rejected.

As to the second part of section 4894, it is clear, from study of the above-recited facts, that here also Chapman has not met the requirements. The statute requires that the applicant shall, within one year after "any action" of which "notice shall have been given to the applicant" prosecute the application, or else the case shall "be regarded as abandoned," unless he shall satisfy the Commissioner of Patents that the longer delay was "unavoidable."

In the instant case the Patent Office (Record, p. 103), required that the claim, based on Fig. 12, be divided as it was only patentable, if at all, in a separate application. The claim referred to was then canceled out, and no action whatever taken as to said Fig. 12 until more than *four* years after the rejection, and *three* years and three months after the cancellation. As to such Fig. 12, therefore, the case plainly became abandoned under the express terms of the statute.

Of course, the statute provides only for abandonment of the "application" which is not in all cases equivalent to abandonment of the *invention*, because where there is no bar of two years' public use or other intervening obstacle, a new and independent application can be filed, but in such case the new application would stand on an entirely different basis from a divisional or continuing application and, in the instant case, would not be possible because of the bar of two years' public use admitted in Chapman's own argument.

Plainly, Chapman, in the instant case, is in the

untenable position of trying to save his case by urging, on the ~~other~~ one hand, that his divisional application is to be treated as it has been by the Patent Office, as a continuation of his early-filed case and, on the other hand, by seeking to avoid the embarrassments of the one-year prosecution statute by asking to have his case treated as if it were a new application.

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Paul Synnestvedt

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where the identical claims of such interference were not made by the applicant until more than one year after the patent containing them was granted to the other party. In the instant case the importance of this question is emphasized by the fact that so far as actual priority is concerned it is conclusively determined in favor of Chapman and Chapman by the records of the Patent Office, because Wintroath admits in his sworn preliminary statement that his date of conception of the invention at issue was eighteen months *later* than the filing date of Chapman and Chapman's original application which fully discloses the subject-matter of the interference.

In the case at bar Chapman and Chapman are applicants, and Wintroath is a patentee, and the interference is between the Wintroath patent and a divisional application filed by Chapman and Chapman one year and eight months after Wintroath's patent was issued. The official dates are as follows:

Wintroath's patent was issued November 25, 1913 (Rec., pp. 37-46).

Chapman and Chapman's divisional application containing the claims of the interference was filed July 6, 1915 (Rec., p. 37).*

Chapman and Chapman's original application fully disclosing the subject-matter of the interference was filed March 10, 1909 (Rec., p. 79).

Wintroath's claimed date of conception is October 1, 1910 (Rec., pp. 55-56).

Wintroath's application was filed December 2, 1912 (Rec., p. 4).

The Court of Appeals, following the rule announced by it in the recent case of *Rowntree* v. *Sloan,* 45 App. D. C., 207, held that because Chapman and Chapman did not make the precise claims of the interference issue

* Paging is confused. See folio 47.

within one year from the date of the Wintroath patent they were estopped to make such claims at all, and accordingly rendered judgment of *priority* in favor of Wintroath, notwithstanding the fact that by his own admission he was not the first inventor of the subject-matter of the interference.

The second question, as it arises in this case, relates to the jurisdiction of the Court of Appeals of the District of Columbia on interference appeals where no question of priority remains undetermined, to consider and determine whether or not a statutory bar exists to the grant of a patent to the acknowledged prior inventor.

In the decision under review the Court of Appeals, notwithstanding the question of actual priority of invention was foreclosed by Wintroath's own admission, held that it had jurisdiction to hear and determine Chapman and Chapman's right to a patent, and in effect held that they had abandoned the invention of the issue *to Wintroath* because of their supposed laches in not having made the claims of Wintroath's patent within one year after that patent was issued.

Summary of Facts.

There is no controversy as to the facts, which are as follows:

Wintroath's application was filed December 2, 1912, and matured into letters patent No. 1,079,679 on December 25, 1913 (Rec., pp. 34-36).

On July 6, 1915, Chapman and Chapman filed their application for patent serial No. 238,254 as a division of their application serial No. 482,517, filed March 10, 1909, *which was then pending in the Patent Office* (Rec., pp. 37-52).* Said divisional application described and

* Paging is confused. This refers to paging beginning with folio 47.

claimed certain subject-matter originally included in said parent application serial No. 482,517, but the claims for which were required to be withdrawn therefrom and made the subject-matter of a separate application (Rec., pp. 118 and 120). Under the practice as it has been established for many years such divisional application related back to and was entitled to date as of the filing date of said parent application. The precise claims of the interference issue were made in such divisional application as filed (Rec., p. 41), which was about one year and eight months after Wintroath's patent containing them was issued.

Although Chapman and Chapman's original application serial No. 482,517 was pending in the Patent Office at the time Wintroath's application was filed and his patent issued, no interference was declared by the Commissioner between the Wintroath application and the Chapman and Chapman original application. The latter application did not contain the precise claims of the interference issue, but it did contain broader claims which dominated that issue, and it was regularly prosecuted according to the statutes and the rules of the Patent Office, and was never abandoned or forfeited. It finally matured into letters patent No. 1,649,633, dated August 10, 1915 (Rec., pp. 78-132).

On March 21, 1916, an interference was declared between the Chapman and Chapman divisional application, serial No. 238,254, and the Wintroath patent (Rec., pp. 53-54). The subject-matter of said interference is defined in claims 2, 3 and 4 of said Wintroath patent, and claims 1, 2 and 3 of the Chapman and Chapman application. It is unnecessary to consider these claims in detail, as it will suffice to say that the invention is the combination with the power shaft of a deep-well pumping mechanism, of a fluid-operated bearing which supports

said shaft, and an auxiliary bearing for sustaining resultant downward thrust of the power shaft. The Chapman and Chapman original application, as filed, *illustrated and described* said subject-matter, and contained claims for *each* of the bearings combined with the power shaft, but it contained no claims for the combination of *both* bearings with the power shaft, and claims for such specific combination were not made by them until they filed their divisional application on July 6, 1915.

The usual preliminary statements were filed by both parties, and in his preliminary statement (Rec., pp. 55, 56) Wintroath declared that he conceived the invention contained in the claims of his said patent on or about the first day of October, 1910, which was more than one year and six months *after* Chapman and Chapman's original application, fully showing and describing said invention, was filed in the Patent Office. In view of the fact that Wintroath's date of conception of the invention was later than Chapman and Chapman's filing date the case did not reach the stage where either party was permitted to take any testimony, and under Rule 111* Chapman and Chapman's preliminary statement was not opened for publication.

On May 5, 1916, in accordance with Rule 114* of the Patent Office, the Examiner of Interferences served notice on Wintroath that judgment on the record would be entered against him unless he should, within 30 days, show sufficient cause why such action should not be taken (Rec., pp. 56, 57).

On June 21, 1916, after having filed certain motions which are not material here, Wintroath moved for judgment on the record in his favor on the ground that Chapman and Chapman were estopped from making the claims

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* See foot note, p. 18.

of the issue; that the facts which raise the estoppel also work an abandonment, and that to award the claims to Chapman and Chapman would, under the facts, be against public policy (Rec., pp. 62, 63).

This motion was based entirely upon the then just published decision of the Court of Appeals of the District of Columbia in the case of *Rowntree* v. *Sloan* (227 O. G., 744; 45 App. D. C., 207), in which it was held that "*Sloan's laches, in failing within a reasonable time after the issuance of the Rowntree patent to make these claims, estopped him to make them at all. . . . If he thought these claims read upon his application, it was his duty promptly to make them, at least within the time allowed for amendment after Office action* (one year), *and his failure to do so is fatal to his present contention.*"

The Examiner of Interferences, in deciding Wintroath's motion for judgment in his favor, held that the doctrine of *Rowntree* v. *Sloan* applied, and awarded priority to Wintroath, *notwithstanding the fact that the records of the Patent Office showed that he was not the first inventor of the subject-matter of the interference* (Rec., pp. 64 to 68, inc.).

Chapman and Chapman accordingly appealed to the Board of Examiners-in-Chief (Rec., pp. 68-70), who affirmed the decision of the Examiner of Interferences on the ground that they were bound by the decision of the Court of Appeals in the Rowntree-Sloan case, and did not feel that they were authorized to set aside the practice instituted by that decision (Rec., pp. 70-71).

Chapman and Chapman thereupon appealed to the Commissioner of Patents (Rec., p. 72), who reversed the decision of the Board of Examiners-in-Chief and the decision of the Examiner of Interferences, and awarded priority of invention to Chapman and Chapman. In deciding the case (Rec., pp. 73-75) the Commissioner said:

"To establish a fixed limit of one year after which claims may not be copied from a patent presents two serious difficulties.

"In the first place, an applicant who has waited more than one year to amend his application may save his rights by showing to the Commissioner that the delay was unavoidable (Revised Statutes, Section 4894). Moreover, generally speaking, laches is a charge which is rebuttable unless the delay exceeds a period specified by statute. No matter what period be taken it seems clear, therefore, that the right to explain the delay must be granted to the applicant.

"In the second place, an inventor after another has patented the invention may wait up to two years before filing his own application therefor (Revised Statutes, Section 4886). Since the making of a claim is a mere incident to the patenting of an invention, a patent could not be denied on any theory of laches in such a case.

"No reason is seen why a stricter rule should be laid down to regulate the conduct of an inventor who has already filed his application at the time when a rival patent is granted than would be applied to one who filed after the rival patent was granted.

"In the Rowntree-Sloan case the question whether the limit of time should be set at one year or two years was not directly involved and therefore presumably was not considered as fully as it would have been had it been necessary for the disposition of the case.

"I am persuaded that on further consideration the Court of Appeals instead of selecting the time allowed for amendment by Section 4894 will follow Section 4886, making the time two years.

"The limit of two years would also be supported by analogy with the treatment of reissue cases in *Miller* v. *Brass Company*, 104 U. S. 350, *Mahn* v. *Harwood*, 112 U. S. 354, and *Wollensak* v. *Reiher*, 115 U. S. 101. There is, however, this difference that whereas the rule in reissue cases demands diligence at all times with especially good explanation if the delay exceeds two years, the diligence of one who, having already filed, copies its claims within two years of the granting of a patent, cannot be inquired into without imposing a condition more strict than

> is imposed by Section 4886 upon one who does not file his application until after the rival patent has been granted" (Rec., p. 74).

Wintroath thereupon appealed to the Court of Appeals of the District of Columbia (Rec., p. 75), which court held that because Chapman and Chapman did not make the precise claims of the interference issue until about one year and eight months after the issuance of the Wintroath patent, they were estopped from making them at all. and that, therefore, Wintroath was entitled to judgment of *priority of invention,* notwithstanding the fact that he did not conceive such invention until more than a year and a half *after* Chapman and Chapman had filed in the Patent Office an application fully illustrating and describing it. Also the court definitely announced its adherence to the doctrine of the Rowntree-Sloan case, with the modification, however, that the period should be one year unless the applicant should satisfy the Commissioner that the delay was unavoidable, but gave Chapman and Chapman no opportunity to present such a showing (Rec., pp. 133-135).

Although Chapman and Chapman's original application was pending in the Patent Office at the time of Wintroath's conception of the invention, and was at all times prosecuted according to law, and their divisional application was filed while their original application was still pending, the Court of Appeals further held that they were guilty of laches in not having made the specific claims of the interference issue within one year after Wintroath's patent was issued; that such laches affected the question of *priority,* and that therefore the court had jurisdiction in the premises,—overlooking, or ignoring, the fact that in such a state of facts what the court is pleased to term "laches" could be no more nor less than the statutory bar of abandonment of the inven-

tion, and that such abandonment, if established, was to the *public* and not to *Wintroath*, and had no bearing on his claim to priority. (Rec., pp. 130-135.)

Judgment was entered accordingly on March 4, 1913. (Rec., p. 136.)

On March 16, 1918, Chapman and Chapman filed their petition for rehearing (Rec., pp. 136-9), which petition was, on the 23rd day of March, 1918, denied. (Rec., p. 139.)

Chapman and Chapman then filed in this court their petition for a writ of *certiorari* to review the judgment of the Court of Appeals with respect to the propositions of law on which it was founded, which petition was granted. (Rec., p. 140.)

Errors Relied Upon.

It is contended on behalf of petitioners that

(*a*) The Court of Appeals erred in holding that an applicant for a patent is estopped from making the claims of a patent for interference purposes after the expiration of one year from the date of issue of the patent.

(*b*) In view of the undisputed fact that Chapman and Chapman were the first inventors of the subject-matter of the issue, the judgment of the Court of Appeals awarding *priority of invention* to Wintroath was erroneous and should be reversed.

(*c*) The question of *priority* as between the parties having been foreclosed by Wintroath's admission that he conceived the invention after Chapman and Chapman's application was filed, the Court of Appeals was without jurisdiction on an interference appeal to consider and determine petitioner's right to a patent for the subject-matter of the interference.

Brief of Argument.

1. An application for patent is a purely statutory proceeding, and an applicant is entitled to all the rights conferred by the patent statutes.

> "A party seeking a right under the patent statutes may avail himself of all their provisions, and the courts may not deny him the benefit of a single one. These are questions not of natural, but of purely statutory right. . . . . No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public."
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> *United States* v. *American Bell Telephone Company, et al.*, 167 U. S. 224 (p. 246).

Under Sec. 4886 Rev. Stat.* an inventor may obtain a patent for his invention provided, among other things, that it was not patented more than *two* years prior to his *application*.

Wintroath's patent was issued Nov. 25, 1913; Chapman and Chapman's divisional application containing the claims of the interference issue was filed July 6, 1915, less than two years thereafter. (Rec., p. 53.)

Therefore, even if their original application be left out of consideration, the Wintroath patent was not a statutory bar to the grant of a patent to Chapman and Chapman.

2. Section 4904† Rev. Stat., which is the statutory authority for the declaration of interferences, fixes no time limit within which the applicant of a pending application must claim an invention already patented to another in order to obtain an interference with such patent, other than that the patent must be *unexpired*.

Wintroath's patent was unexpired, and therefore

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* See p. 17.

† See p. 19.

Chapman and Chapman were lawfully entitled to contest priority with him.

3. It is not disputed that Chapman and Chapman's original application fully discloses the subject-matter of their divisional application and of the interference issue, and was never abandoned or forfeited, but was regularly prosecuted according to law and the rules of the Patent Office.

Such original application was filed March 10, 1909; Wintroath's claimed date of conception of the invention in controversy is October 1, 1910. (Rec., p. 55.)

Therefore, considering Chapman and Chapman's original application merely as proof of their priority over Wintroath, they are indubitably the first inventors of the issue of the interference.

Victor Talking Mach. Co., et al., v. *Am. Graphophone Co.*, 145 Fed. 350 (p. 351).

Auto. Weighing Mchn. Co. v. *Pneumatic Scale Co.*, 166 Fed. 288.

Sundh Elec. Co. v. *Interborough Rapid Transit Co.*, 198 Fed. 94.

Lemley v. *Dobson-Evans Co.*, 243 Fed. 391.

4. Interferences are authorized for the sole purpose of determining the question of *priority of invention.*

"The statute is explicit. It limits the declaration of interferences to the question of priority of invention."

Lowry v. *Allen*, 203 U. S. 476.

Ewing v. *U. S. ex rel Fowler*, 244 U. S. 1, p. 11.

It follows that inasmuch as Chapman and Chapman's applications (divisional as well as original) were filed less than two years after the grant of Wintroath's patent, and their priority over Wintroath is incontrovertibly established, judgment should have been rendered in their favor.

Ewing v. *U. S. ex rel Fowler, supra.*

5. The rule announced by the Court of Appeals of the District of Columbia in the case of *Rowntree* v. *Sloan*, 45 App. D. C. 207, and applied in the case at bar, that failure of an applicant to make the claims of a patent within one year after the issuance of the patent estops him to make them at all, is judicial legislation, and is directly in conflict with sections 4886 and 4904 Rev. Stat.

For more than forty years it has been the practice of the Patent Office to declare interferences between applicants and patentees where the applicant made affidavit showing his conception of the invention prior to the filing of the patentee's application. As far back as 1870, Rule 51* provided that interferences would be declared "when an applicant having been rejected upon a prior unexpired patent or the prior application of another, claims to have made the invention before the prior applicant or patentee." (See Lowery's Annotated Interference Rules, p. 7.)

Moreover, until the amendment of March 3, 1897, to Sec. 4886 Rev. Stat., which introduced the words "or more than two years prior to his application," a prior unexpired patent was never a bar to the grant of a patent to an applicant who could prove his claim to priority over it, regardless of when his application was filed.

Schreeve v. *Grissinger*, 202 O. G. 951; C. D., 1914, 49 (p. 51).

Sec. 4904 Rev. Stat. provides for the declaration of interferences between an application and *any unexpired* patent, so that reading the latter section in connection with Sec. 4886, when the Commissioner is of the opinion that an interference exists between an application and any unexpired patent issued not more than *two* years before the *application was filed*, the applicant has a

* See foot note, p. 17.

statutory right to the declaration of such interference, and on proving priority, to receive his patent.

Ewing v. *U. S. ex rel Fowler, supra.*

6. An applicant who prosecutes his application according to law and the Patent Office Rules is not chargeable with laches.

> "Neither can a party pursuing a strictly legal remedy be adjudged in the wrong if he acts within the time allowed and pursues the method prescribed by the statute."
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> *U. S.* v. *American Bell Telephone Co. et al.*, 167 U. S. 224 (p. 246.)
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> *Crown Cork & Seal Co.* v. *Aluminum Stopper Co.*, 108 Fed. 845 (p. 851).
>
> *Columbia Motor Car Co.* v. *C. A. Duerr & Co.*, 184 Fed. 893 (p. 895).

Chapman and Chapman's original and divisional applications were both at all times prosecuted strictly according to law and the rules of the Patent Office, and were never abandoned or forfeited. Consequently the finding of the Court of Appeals that they were guilty of laches was erroneous.

7. The time when a claim is first made is immaterial, as when made it relates back to the date of filing of the application, and if made in a divisional application, it relates back to the date of filing of the original or parent application.

Lotz v. *Kenny*, 31 App. D. C. 205.

Von Reclinghausen v. *Dempster*, 34 App. D. C. 474.

8. Sec. 4894 Rev. Stat.* relates to the prosecution of *applications* to save them from abandonment, and has nothing whatever to do with abandonment of *inventions*. It does not apply to the case at bar because it cannot be disputed that Chapman and Chapman's appli-

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* See p. 18.

cations were amended from time to time, in each case within one year from the last preceding official action, as required by law and the Patent Office Rules. (See Rules 31, 68, 77 and 171.*)

9. The effect of the ruling of the Court of Appeals in this case is that Chapman and Chapman constructively abandoned their invention to Wintroath, a later inventor, and that such constructive abandonment occurred while they had still pending, and were regularly prosecuting, an application for patent therefor.

The patent laws do not recognize such a thing as the *constructive* abandonment of an invention for which an applicant has lawfully filed, and is regularly prosecuting, an application for patent. Abandonment of an invention is a question of fact, and must be proven.

Ide v. *Trorlicht Co.*, 115 Fed. 144.

Saunders v. *Miller*, 33 App. D. C. 456.

Miller v. *Eagle Mfg. Co.*, 156 U. S. 186.

Rolfe v. *Hoffman*, 26 App. D. C. 336 (p. 340).

Kinnear Mfg. Co. v. *Wilson*, 142 Fed. 970 (p. 973).

Abandonment of an invention is a very different thing from abandonment of an application for patent.

Western Elec. Co., v. *Sperry Elec. Co.*, 58 Fed. 186 (p. 191).

Hayes-Young Tie Plate Co. v. *St. Louis Transit Co.*, 137 Fed. 82.

General Electric Co. v. *Continental Fibre Co.*, 256 Fed. 660 (p. 663).

Abandonment of an invention completed and reduced to practice by the filing of an allowable application for patent therefor inures to the benefit of the public, and not to the benefit of a later inventor.

Ex parte Gosselin, 97 O. G. 2977 (2979).

Millet & Reed v. *Com. of Patents*, 18 App. D. C. 186 (96 O. G. 1241).

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* See foot note, pp. 17 and 18.

Patent Office Rules 31, 68, 77 and 171, which provide for amendment of applications within one year from the date of the last official action of the Patent Office, all relate to abandonment of *applications.*

The statutes relating to constructive abandonment of *inventions* in all cases fix a limit of *two* years except when the application is filed in a foreign country more than one year before application is made in this country. (See Rev. Stat. Sections 4886, 4887, 4897 and 4920.)*

The rule as to constructive abandonment in the case of applications for reissue, generally, though not invariably, fixes a limit of *two* years.

Miller v. *Brass Co.,* 104 U. S. 350.
Mahn v. *Harwood,* 112 U. S. 354.
Wollensack v. *Reiher,* 115 U. S. 101.

10. The rule devised by the Court of Appeals in *Rowntree* v. *Sloan,* that failure of an applicant to make the claim of an unexpired patent within one year from the date of such patent estops the applicant to make such claim at all, is arbitrary because it has no foundation in law, and is illogical because, if there be any ground for invoking the doctrine of estoppel in such a case, there is no reason why it should apply in one year rather than at any other time.

11. There can be no question of estoppel as between Chapman & Chapman and Wintroath because the basic conditions to create an estoppel do not exist.

There was no privity of relationship between the parties.

Chapman and Chapman were unaware of Wintroath's application for patent.

Wintroath was not misled to his injury by any act or failure to act of Chapman and Chapman.

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* See pp. 17 to 20.

It was not Chapman and Chapman's duty, but the Commissioner's to ascertain if there was an interference, and to declare it. *Ewing* v. *ex rel. Fowler,* supra. Sec. 4904 Rev. Stat.

See Bigelow on Estoppel—Fifth Ed. Pages 26-28; 585; 594-597.

12. The apparent disapproval of the Court of Appeals of the existing statutory provisions governing the filing and prosecution of applications for patent, does not justify legislation by that court to correct what it conceives to be unwise, or against public policy. Congress is the only body endowed under the constitution with legislative power.

Boston Store v. *American Graphophone Co. et al.,* 246 U. S. 8 (pp. 25-6).

13. Laches or estoppel in this case is not ancillary to the question of priority, as Chapman and Chapman had completed the invention in controversy, had filed their application for patent therefor, and were regularly prosecuting such application, more than two years before Wintroath's conception of such invention.

14. The question of actual priority of invention having been foreclosed by Wintroath's admission, the Court of Appeals was without jurisdiction on an interference appeal to hear and determine Chapman and Chapman's right to a patent.

Norling v. *Hayes,* 37 App. D. C. 169.

Lowry v. *Allen,* 203 U. S. 476.

Statutes Involved.*

Sec. 4886. Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than *two years prior to his application*, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

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*Patent Office Rules Involved.

Rule 51 of 1870: Interferences will be declared in the following cases, when all the parties claim substantially the same patentable invention:

. . . . . .

Second. When an applicant having been rejected upon the prior unexpired patent or the prior application of another, claims to have made the invention before the prior applicant or patentee.

Third. When an invention is claimed in a renewed application which is shown or claimed in an application filed or unexpired patent granted prior to the filing of such renewed application. . . .

(See Lowery on Interference Proceedings, pp. 4-7.)

Rule 31. . . . The application must be completed and prepared for examination within one year after the filing of the petition; and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action thereon (Rule 77), of which notice shall have been duly mailed to him or his agent, the application will be regarded as abandoned, unless it shall be shown to the satisfaction of the Commissioner that such delay was unavoidable. (See Rules 171 and 172.)

Rule 68. The applicant has a right to amend before or after the first rejection or action; and he may amend as often as the Examiner presents new references or reasons for rejection. . . .

Rule 77. If an applicant neglect to prosecute his application for one year after the date when the last official notice of any action by the office was mailed to him, the application will be held to be abandoned, as set forth in Rule 171. . . .

Rule 93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent

Sec. 4887. . . . But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than *two years* before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing.

Sec. 4894. All applications for patents shall be com-

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an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

Rule 94. Interferences will be declared in the following cases, when all the parties claim substantially the same patentable invention; . . .

(2) Between an original application and an unexpired patent containing conflicting claims, when the applicant, having been rejected on the patent, shall file an affidavit that he made the invention before the patentee's application was filed. . . .

Rule 111. . . . A party who alleges no date in his preliminary statement earlier than the filing date of the application or applications of the other party or parties shall not have access to the preliminary statement of said party or parties.

Rule 114. If the junior party to an interference, or if any party thereto other than the senior party, fails to file a statement, or if his statement fails to overcome the *prima facie* case made by the respective dates of application, such party will be notified by the Examiner of Interferences that judgment upon the record will be rendered against him at the expiration of thirty days, unless cause is shown why such action should not be taken.

Rule 116. In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they filed their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

Rule 117. The preliminary statement can in no case be used as evidence in behalf of the party making it.

Rule 171. An abandoned application is one in which all the essential parts have not been filed so that it is completed and prepared for examination within a period of one year, or which the applicant has failed to prosecute within one year after any action therein of which notice has been duly given (see Rules 31 and 77), or which the applicant has expressly abandoned by filing in the office a written declaration of abandonment, signed by himself and assignee, if any, identifying his application by title of invention, serial number, and date of filing. (See Rule 60.)

Prosecution of an application to save it from abandonment must include such proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment under section 4894 of the Revised Statutes.

pleted and prepared for examination within one year after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable.

Sec. 4897. Any person who has an interest in an invention or discovery, whether as inventor, discoverer, or assignee, for which a patent was ordered to issue upon the payment of the final fee, but who fails to make payment thereof within six months from the time at which it was passed and allowed, and notice thereof was sent to the applicant or his agent, shall have a right to make an application for a patent for such invention or discovery the same as in the case of an original application. But such second application must be made within two years after the allowance of the original application. . . . And upon the hearing of renewed applications preferred under this section, abandonment shall be considered as a question of fact.

Sec. 4903. Whenever, on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant persists in his claim for patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case.

Sec. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any *unex-*

pired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the Commissioner shall prescribe.

Sec. 4920. In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

. . . . . .

Third. That it had been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or . . .

Fifth. That it had been in public use or on sale in this country for more than two years before hi application for a patent, or had been abandoned to the public.

ACT OF FEB. 9, 1893, CH. 74; 27 STAT. L., 434.

Sec. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be, and the same is hereby, vested in the court of appeals created by this act; and in addition any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals.

ARGUMENT.

First Question.

Under Section 4886, Rev. Stat., an issued patent is not a bar to the grant of a patent for the same invention to a *later* applicant unless the later application was filed more than *two* years after the grant of the patent, and under no circumstances does the Statute make the issuance of a patent to one inventor a bar to the grant of a patent for the same invention to an *earlier* applicant who is duly prosecuting his application. On the contrary, Section 4904, Rev. Stat., specifically makes provision for the determination of the question of priority as between the patentee of *any unexpired* patent and an applicant having a pending application in the Patent Office.

It follows, therefore, that an applicant, whose pending application for patent was filed in the Patent Office less than two years after the grant of a patent to another for the same invention, has an absolute right to have the question of priority determined as between him and the prior patentee, and if the applicant should prove to be the first inventor, he is entitled under the Statutes to the grant of a patent to him for such invention. It would be a manifest absurdity to hold that this rule does not apply where the applicant's application was filed *earlier* than the patentee's application, or before the granting of his patent.

This practice has been consistently followed by the Patent Office for more than forty years, and until the decision of the Court of Appeals of the District of Columbia in the case of *Rowntree* v. *Sloan* (45 App. D. C. 207), its legality was unquestioned. In the case of

Rolfe v. *Hoffman,* that court, in an opinion by Mr. Justice Duell, formerly Commissioner of Patents, said:

> "It is true that two years elapsed between his alleged reduction to practice and the filing of his application for patent, during which interval his rival entered the field and secured a patent. Such a period of delay, standing by itself does not constitute an abandonment of his right to a patent based on priority of invention. An inventor having reduced his invention to practice is entitled to a period of two years in which to put the same in public use and on sale without a forfeiture of his right to receive a patent based upon an application filed before the statutory bar has arisen. Neither abandonment nor forfeiture within that period can be presumed but must be proven.
>
> *Rolfe* v. *Hoffman,* 26 App. D. C. 336 (p. 340); 1906 C. D., 588, pp. 590-1 (121 O. G., 1350).

The Rowntree-Sloan decision, however, announced the novel doctrine that unless an applicant introduced into his application claims corresponding with those of an issued patent within *one* year from the grant of such patent, he was estopped from making such claims at all, thereby making the failure of an applicant to make claims corresponding to those of a patent within *one* year from the grant thereof operate as *an abandonment* by him *to the patentee* of the *invention* defined by such claims.

Not only is this doctrine entirely without foundation in law, but it is absolutely inconsistent with Section 4886, Rev. Stat. For example, under Section 4886, an inventor may put his invention into public use for any period less than two years, and may then file his application for and receive a valid patent for his invention, notwithstanding anything that may have been done by later inventors in the meantime. After the first inventor has put his invention into public use, and before he has

filed his application for patent, a later inventor may apply for and receive his patent, and it is quite possible, and occasionally happens, that such later inventor may receive his patent more than a year before the first inventor makes his application, but, under Section 4886, the issuance of such patent to a later inventor in no way vitiates the right of the first inventor to receive his patent after he has duly established the priority of his invention.

Applicant's Rights Fixed by Statutes.

The rights of inventors to patent protection are purely statutory and cannot be abridged by the courts. This court in the case of *U. S.* v. *Telephone Company* very fully considered this precise question and held that the conditions under which an applicant may apply for and receive a patent are determined by statute, and in the absence of fraud it is beyond the power of the courts to change or modify those conditions. For example, since the statutes prescribe on what terms an application may be prosecuted in the Patent Office in the way of responding to official actions by amendment or argument, and allow a term of one year within which to reply to any official action, it is beyond the power of the courts to change that term and to hold that a case has become abandoned where the applicant has complied with the law in the prosecution of his application. We quote as follows from the opinion filed in that case:

> "Neither can a party pursuing a strictly legal remedy be adjudged in the wrong if he acts within the time allowed and pursues the method prescribed by the statute. If the statute gives him five years within which to bring an action on a note, he cannot be denied the relief simply because he waits four

years and eleven months. If he has two years after a judgment against him within which to take an appeal, he may wait until the last day of the two years. Under Section 4886, Revised Statutes, an inventor has two years from the time his invention is disclosed to the public within which to make his application, and unless an abandonment is shown during that time he is entitled to a patent, and the patent runs, as any other patent, for seventeen years from its date. He cannot be deprived of this right by proof that if he had filed his application immediately after the invention the patent would have been issued two years earlier than it was, and the public therefore would have come into possession of the free use of the invention two years sooner. **The statute has given this right, and no consideration of the public benefit can take it from him.** His right exists because Congress has declared that it should. It will not do to say that, because Congress has declared that seventeen years is the life of a patent, seventeen years is the limit of the possible monopoly; for the same legislation that gives seventeen years as the life of a patent gives two years within which an application for a patent may be made, and during that time, as well as while the application is pending in the Department, the applicant has practically, if not legally, an exclusive use. A party seeking a right under the patent statutes may avail himself of all their provisions, and *the courts may not deny him the benefit of a single one.* These are questions not of natural but of purely statutory right. Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent. **No court can disregard any statutory provisions in respect to these matters on the ground that in its judgment they are unwise or prejudicial to the interests of the public."**

U. S. v. *American Bell Telephone Co. et al.*, 167 U. S., 224 (p. 246), C. D., 1897, 442, pp. 449-50 (79 O. G., 1362).

To the same effect is the decision of the Circuit Court of Appeals for the 4th Circuit in the case of *Crown Cork & Seal Co. of Baltimore City* v. *Aluminum Stopper Co.*

of Baltimore City et al. In the latter case the court said:

"Again, it is strenuously urged that the delays in the Patent Office pending the application worked a forfeiture. The record shows that the inventor encountered serious difficulties in the securing of his patent, successive objections being interposed by the Examiner, necessitating appeals. In each case, however, the necessary steps were taken within the two years limited by the statute, and during the long period which intervened between the filing of the application and the issuance of the patent, although there are abundant signs of discouragement there are none of abandonment, for toward the end of each period of limitation he resumes the struggle, and although often stricken down he did by successive appeals and in strict conformity with the requirements of the statute, at last succeed in establishing his right to the patent. The argument of the learned counsel assumes that the inventor is under some sort of obligation to give the public the benefit of his invention as speedily as possible and that he is in fault for any avoidable delay. The inventor does not determine the measure of his rights or of his obligations. The law determines that for him, and if the Government thinks that more speed is desirable in the interest of the public *it should change the law. The courts cannot do so.* Nor can they exact of inventors any degree of diligence other than compliance with the statutory provisions, official regulations, departmental requirements, and formal demands which are prescribed by and for the officials and others charged with duties under the patent laws. Certain fixed periods are provided in Sections 4894 and 4904, Revised Statutes, for securing progress in applications for patents. If the inventor is allowed two years after a judgment against him within which to take appeal, he may wait until the last day of the two years. If Congress thinks this too long a time, it should fix another limitation; **but courts cannot deny the benefits which the statute gives.** There are no special reasons for invoking that power in this case if we had it, for it does not appear that during all these years of delay any other inventor was attempting to enter the field. This

whole subject had full consideration in *U. S.* v. *American Bell Tel. Co.* (C. D., 1897, 442; 79 O. G., 1362; 167 U. S., 224; 17 Sup. Ct., 807; 42 L. Ed., 144), where there was a delay of fourteen years in the Patent Office."

Crown Cork & Seal Co. v. *Aluminum Stopper Co.*, 108 Fed., 845 (p. 851), C. D., 1901, 450, pp. 457-8 (96 O. G., 2573).

The Circuit Court of Appeals for the Second Circuit expressed the same views in the suit on the Selden patent. We quote as follows:

"It is urged that we should regard unfavorably the patent on account of this delay in the Patent Office, should seek to avoid giving it a broad construction, and should permit the alleged abuse of the law to weigh against the standing of the complainants in a court of equity. But the patentee acted wholly within his rights. He merely took advantage of the delays which the law permitted him. He followed strictly the statutes and rules of procedure, and the courts cannot exact a greater measure of diligence from him. When the patent was granted under the authority of the law, it became entitled to the consideration accorded to any other patent. If the statutes and rules permit unnecessary delays, they should be changed; but we reject the view that this court owes any duty to relieve against their operation. This patent, even if it be useful only for tribute, must be viewed without prejudice and with absolute judicial impartiality."

Columbia Motor Car Co. et al. v. *C. A. Duerr & Co. et al.*, 184 Fed. 893 (p. 895).

Time When Claims Made Immaterial.

It has also been established law for many years that an applicant for patent, at any time during the prosecution of his application, is entitled to make claims commensurate with his invention, and that such claims, when

made, date back to the date of filing of his application. If made in a divisional application filed while the original application is pending, as in the case at bar, they relate back to the date of filing of the original, or parent, application, and *prima facie,* the date of filing of such original application is considered the date of making of the invention.

"It is settled law that claims may be introduced into an application by amendment, and, if their subject-matter is sufficiently disclosed by the application as filed, *even though not theretofore claimed,* they may relate back to and receive all the benefits and advantages incident to the earlier filing date. It is equally well settled that if, under the rules of the Patent Office, division is required between the later claims and those previously contained in the application, the original and the divisional applications will be treated as continuous, and the date of filing of the original will be accorded the applicant as the date of constructive reduction to practice for both. (*Duryea* v. *Rice,* C. D., 1907, 443; 126 O. G., 1357; 28 App. D. C., 423; *Lotz* v. *Kenny,* C. D., 1908, 467; 135 O. G., 1801; 31 App. D. C., 205.)

"**True, the claims to the invention here in issue were never specifically presented in the earlier case; but the effect cannot be other than the same.** To hold that it was necessary for appellee to insert the claims in issue in the original application in order to obtain the benefit of its filing date before presenting them in the division, would be to require that which would involve considerable delay in the prosecution of the case and which could accomplish no beneficial purpose. No such rule seems to have been contemplated by the Commissioner in *Hopfelt* v. *Read* (C. D., 1903, 319; 106 O. G., 767), quoted with approval in *Duryea* v. *Rice, supra,* when, speaking of the question of constructive reduction to practice, he said:

" 'This is so when two applications are pending contemporaneously and the first is not abandoned, whether the claims are presented in the original application itself or in a later application filed as

a division or a continuation of the original application, as in the second case the later application dates back to the earlier one. It is only necessary that the description in both applications shall be sufficient to support the claims. The fact that the Office practice may prohibit the prosecution and allowance of the claims in an earlier application does not prevent an applicant from availing himself of the earlier date of filing as his date of constructive reduction to practice when he files a later application containing the same description and the claims based upon the same.'

"But counsel for appellant contend that the earlier application stood wholly rejected. It is true that the claims of the earlier application had been awarded to another party as the result of the former interference, but appellee was entitled to one year from February 25, 1905, in which to take such action as he desired. Within that time, he filed the application here in issue. Was there an application pending in the Office to which the divisional application might attach? This is the question upon which the authorities seem to turn. Here we think there was. Until the period of one year had elapsed, this application was susceptible of amendment, and, if claims had been presented which met with the approval of the patent Office, a valid patent could have been issued thereon. In fact, appellee presented an amendment which was acted upon by the Primary Examiner February 2, 1906.

. . . . . .

"The case of *Lotz* v. *Kenny, supra,* we think is decisive of this case. There the appellee had filed an application showing and describing the invention in issue, but not specifically claiming the same, and *no claims were inserted thereto until after a patent had been issued to the appellant.* On July 15, 1905, the Patent Office held these claims to be for a distinct and separate invention and required the appellee to restrict his application to the invention originally claimed. In the meantime, however, on June 1, 1905, the latter filed the application there in issue. We are unable to see any material difference between that case and the one at bar. There,

as here, the claims in issue were not presented until after a patent had issued to the adverse party. Although these claims were first inserted in the original application, appellee did not await a ruling of the Patent Office as to the necessity of division, but incorporated them in a second application, no less distinct from the parent application than the one at bar; and yet the court held them to constitute a continuous transaction, saying:

> "'It is quite clear that the invention of the issue was disclosed in the prior applications, though *no specific claims therefor were made until after the issue of the patent to Lotz.* The claims could have been inserted therein by amendment, but for the rule of the Patent Office which does not permit a patent to issue for two separate inventions. Under such conditions, nothing remained but to file a new and divisional application, or to abandon this part of the invention.'"
>
> *Von Recklinghausen* v. *Dempster,* 34 App. D. C., 474 (154 O. G., 252).

Following the matter quoted from *Lotz* v. *Kenny* in the above decision, the Court of Appeals, D. C., in the case of *Lotz* v. *Kenny,* goes on to say:

> "The first contention on behalf of the appellant is that, as section 4888 Revised Statutes requires that the application shall not only contain a full description of the invention but also contain claims for the same, it is not permissible to amend by setting up a new claim to the invention or a part thereof not before claimed. The unsoundness of this proposition in a case where the subject-matter is contained in the application though not followed by a specific claim therefor, has been pointed out in the recent case of *Phillips* v. *Sensenich, ante,* 14; 134 O. G., 1806.
>
> "Where the conditions of the original application require division instead of its amendment merely, to secure a patent embracing the additional claims, the rule is necessarily the same, as held in the case last cited; and the new application dates back to

the original one, securing to the applicant the benefit of a constructive reduction to practice as of that date. (*Duryea* v. *Rice,* C. D., 1907, 443; 126 O. G., 1357; 28 App. D. C., 423, 435.)

"It is further contended that by Kenny's failure to make the specific claim of the invention of the issue under his original application, or by division, until after Lotz entered the Office with an application therefor, he must be regarded, as to Lotz at least, as having lost his right now to make the claim. The following decisions are relied on to support this contention: (*Miller* v. *Brass Co.,* C. D., 1882, 49; 21 O. G., 201; 104 U. S., 352; *Railroad Co.* v. *Sayles,* C. D., 1879, 349; 15 O. G., 243; 97 U. S., 554; *Bechman* v. *Wood,* C. D., 1899, 453; 89 O. G., 2459; 15 App. D. C., 484.) *Miller* v. *Brass Co.* was a case of a reissued patent, and it was there held that when a specific device or combination only is claimed, and a patent issued therefor, any other device or combination disclosed but not claimed is regarded as abandoned to the public, unless at least, with due diligence the patentee applies for reissue, and shows clearly that his omission to make the claim was the result of inadvertence, accident, or mistake. The present is not a case of that kind, nor does it come within the rule governing the other two cases. In both there were, after long delay, material alterations of the specifications so as to cover the invention then claimed. In *Bechman* v. *Wood* (C. D., 1899, 453; 89 O. G., 2459; 15 App. D. C., 484, 491), the original specifications did not disclose the broad claim of the issue, and it was not made for nearly three years after filing, and after Bechman had entered the Office making a claim for another specific form of the generic invention; and it was said, on the authority of *Railway Co.* v. *Sayles* (C. D., 1879, 349; 15 O. G., 243; 97 U. S., 554):

> " 'But it was not competent for Wood so to alter the specifications as to interfere with other inventions made prior to the alteration.'

"Where, as in this case, the invention was shown in the original application, and the making of the claim involved no material alteration of the specifi-

cations, the Rule in Bechman v. Wood does not apply. (*McBerty* v. *Cook,* C. D., 1900, 248; 90 O. G., 2295; 16 App. D. C., 133, 138; *Luger* v. *Browning,* C. D., 1903, 593; 104 O. G., 1123; 21 App. D. C., 201, 205.) In that case it was said:

> "'It is sought, also, to bring this case within the ruling of *Bechman* v. *Wood* (C. D., 1899, 453; 89 O. G., 2459; 15 App. D. C., 484) and *Chicago & N. W. Ry. Co.* v. *Sayles* (C. D., 1879, 349; 15 O. G., 243; 97 U. S., 554), which latter was the decision that determined the ruling in *Bechman* v. *Wood.* The contention of the appellant in this regard, if sustained, would apply to all cases in the Patent Office wherein the claim of one application is suggested to another applicant for the purpose of an interference thereupon to be declared. But the case of *Bechman* v. *Wood,* as explained in the case of *McBerty* v. *Cook,* was not intended to have any such application. The distinction is well pointed out by the Board of Examiners-in-Chief in their opinion filed in this case. It is that, when new matter is introduced into an application, it cannot be allowed to dominate previous claims of another applicant; but that **when matter has been previously disclosed, although not formally claimed, it is proper to be included in a subsequent formal claim, and may take precedence of previous claims advanced by another applicant.** (See also, *Furman* v. *Dean,* C. D., 1905, 582; 114 O. G., 1552; 24 App. D. C., 277, 281.)'"
>
> *Lotz* v. *Kenny,* 31 App. D. C., 205 (135 O. G., 1801).

The case of *Lowry* v. *Spoon* is also directly in point. We quote as follows from that case:

> "The records show, however, that before Lowry's filing date Spoon had filed an application October 24, 1896, for a patent upon the press with which the bale now in controversy was made, and the operation of that press in making the bale was described. The bale was disclosed, but the claims were there confined to the apparatus, *and none was made to the*

bale. The application involved in the interference was filed as a division of the earlier application, and by reason of that earlier application Spoon was made the senior party to the interference.

"Lowry's contention is that since his application was filed and his patent was granted when there was no other application in the Patent Office claiming the invention the presumption is in favor of the validity of his patent.

. . . . . .

"A divisional application entitles the applicant to the benefit of the date of the original application from which is was divided. The two applications constitute parts of one continuous proceeding. (*Dederick* v. *Fox,* 63 O. G., 1916; *Cain* v. *Park,* 86 O. G., 797.) **The question whether the claims are in the original or the divisional case is not of consequence,** and therefore if Spoon is to be deprived of the benefit of his early filing date it is because of the time when he presented the claims and not because of the fact that they are in a divisional application. His rights are the same as if the claims were inserted in the original case by an amendment, since a divisional application is, in effect, an amendment. A party has the right to amend while his application is pending, and to attempt to give the several claims effect as of the date when they were made rather than the date when the application was filed would lead to endless confusion. After a party asserts inventorship of a particular thing by making a claim to it, whether originally or by amendment, the only thing remaining to be determined is the time when he was first in possession of it. **If he is entitled to claim it at all, the Office records show that he was in possesoin of it when he filed his application. It would seem that no one who made the invention subsequent to that date can be regarded as the first inventor. In the absence of proof of prior invention by another the judgment must be in his favor."**

Lowry v. *Spoon,* 110 O. G., 858.

The authorities cited clearly hold that it is immaterial whether or not Chapman and Chapman claimed the

subject-matter of the issue in the parent application. That it was fully shown and described therein is not disputed, and that is all that is material here. Those familiar with Patent Office practice are well aware of the difficulties which inventors encounter in formulating claims which will pass the strict scrutiny to which they are subjected by the Examiners, and it is the rule rather than the exception that several actions are necessary before an applicant succeeds in placing his claims in proper condition for allowance over the references cited. An inventor not infrequently fails to recognize just what invention he has made over the prior art, and as applications are usually filed without previous examination of the patented art, an applicant often fails to draw his claims for novel combinations, particularly where the elements entering into such combinations are themselves believed to be novel. In the present case, the issue is drawn to cover the combination of certain bearings in a deep well pumping mechanism—that is to say, a fluid-operated bearing for supporting the power shaft and impeller on a fluid surface, and auxiliary bearing means for sustaining any resultant downward thrust of said power shaft. At the time of filing their application Chapman and Chapman believed that the fluid-operated bearing *per se* was novel and claimed it separately. They also believed that their auxiliary bearing was novel and claimed that separately. They apparently did not at that time realize that the invention resided in the combination of these two bearings with the same power shaft, and therefore did not claim such combination. That fact, however, in no wise prejudiced their right to claim the combination at any time during the pendency of their application, since it is unquestionable that the disclosure of their original application fully covers it.

The case of *Dunkley* v. *Beekhuis*, 39 App. D. C., 494, was one in which a patent issued to Beekhuis pending the application of Dunkley, and his claims were copied by the latter for the purpose of procuring the declaration of an interference. All the tribunals of the Office found that Dunkley was the first to conceive and reduce to practice, provided he was entitled to make the claims of the issue, and that was the single issue of the case. It appears that the controversy was over the action of certain jets of water, termed in the claims "peeling water jets," or "peeling jets of water," and the Commissioner awarded priority to Beekhuis principally on the ground that Dunkley had contemplated only using the jets of water for washing purposes and had not contemplated effecting the peeling by their action. The Court of Appeals, D. C., however, held that it was apparent that the jets of Dunkley would have the effect to remove the skins as well as to cool and wash the fruit, and that even though Dunkley did not realize the peeling effect of his jets, in view of the fact that such jets did operate to produce that result, he was entitled to claim the invention. They say:

> "Dunkley was the first to invent and put into practice a rapid and effective machine for peeling peaches. This comprised in the combination the jets of water which he evidently realized aided in the removal of the skins when disintegrated by the alkali solution. That he did not realize the full extent of their agency cannot deprive him of the benefits accruing from their use.
>
> "His specifications and construction afforded sufficient foundation for the claims; and as he was the first to conceive the idea and reduce it to successful practice, he is entitled to the award of priority."
>
> *Dunkley* v. *Beekhuis*, 39 App. D. C., 494; C. D., 1913, 362, pp. 365-6; 190 O. G., 267.

The same rule is recognized and applied by the Federal Courts. On this point the decision of the U. S. Circuit Court of Appeals for the 6th Circuit, in the case of *Cleveland Foundry Co. et al.* v. *Detroit Vapor Stove Co.*, clearly states the law. In an opinion by Judge Severens the court says:

> "It is true that the patentee did not fully perceive nor correctly perceive, as we think, the principles on which the operation of his burner proceeded. For instance, we more than doubt whether he appreciated that the principle of gravity co-operated in the method of his invention. But he did see and know that the burner he had devised would successfully accomplish the results he anticipated and was laboring for. It is clear enough that while the application was pending he came to understand the operation of his device better than he had, and that his first claim was founded on that better understanding. These are the essential facts on which the issue as to whether such new matter was brought in and claimed as would defeat the validity of the claim must be tested. We think this issue must be determined in favor of the patent. In the case of *Michigan Central R. R. Co.* v. *Consolidated Heating Co.*, 67 Fed. 121, 14 C. C. A., 232, we had occasion to consider the question of the validity of amendments made while the application for a patent was pending. We there held that the validity of such an amendment depended upon the question whether it brought in original matter, or was of something that might be fairly deduced from the original application. In the first instance the amendment would not be justified; in the latter it would. The case was decided upon that distinction. And this is the rule which is elsewhere recognized. *Hobbs* v. *Beach*, 180 U. S. 396, 21 Sup. Ct. 409, 45 L. Ed. 586; *Western Electric Co.* v. *Sperry Electric Co.*, 58 Fed. 186, 7 C. C. A. 164; *Sugar Co.* v. *Yaryan Mfg. Co.* (C. C.), 43 Fed. 140. This distinction harmonizes with the doctrine that the benefit secured by an invention extends to all the uses of which it is capable, whether the inventor had them all in contemplation or not, and the other rule, to which we

have already referred, that it does not matter that he does not understand the principles on which his device operates. If he discovers new uses to which his invention may be put, or discerns the principles thereof more clearly, while his application is pending, in neither case is there any new invention nor any enlargement of the old. And, that being so, there can be no legal objection to his so molding his claims as to secure all his invention discloses."

Cleveland Foundry Co. v. *Detroit Vapor Stove Co.*, 131 Fed. Rep., 853, pp. 857-8.

As the Commissioner well said, "an inventor after another has patented the invention may wait up to two years before filing his own application therefor (Revised Statutes, Section 4886). Since the making of a claim is a mere incident to the patenting of an invention, a patent could not be denied on any theory of laches in such a case." (Record, p. 74.)

The rule is well stated by the Circuit Court of Appeals for the Second Circuit as follows:

"The specifications in that application for 564,586, were full enough to warrant the making of the claims here in controversy (5 and 35). At any time the application might have been amended by adding such claims, and in our opinion it is immaterial that, instead of thus amending it, he took the broader claims on another application, filed while the first was pending. The second may fairly be considered a continuation of the first, and thus Berliner's application antedates the public use, and the facts will not sustain the contention that he abandoned his invention here in suit."

Victor Talking Mach. Co. et al. v. *American Graphophone Co.*, 145 Fed. 350 (p. 351).

See also:

Auto. Weighing Mchne. Co. v. *Pneu. Scale Corpn.*, 166 Fed. 288 (C. C. A., 1st Cir.).

Lemley v. *Dobson-Evans Co.*, 243 Fed. 391 (C. C. A., 6th Cir.).

Sundh Elec. Co. v. *Interborough Co.*, 198 Fed., 94 (C. C. A., 2nd Cir.).

Rule 116 of the Patent Office recognizes and applies this principle as follows:

> "Rule 116. In original proceedings in cases of interference the several parties will be presumed to have made the invention in the chronological order in which they filed their completed applications for patents clearly illustrating and describing the invention; and the burden of proof will rest upon the party who shall seek to establish a different state of facts."

It is not disputed that Chapman and Chapman's applications have at all times been prosecuted strictly according to law and the rules of the Patent Office. Nevertheless, in the case at bar the Court of Appeals, despite the fact that its attention was directed both orally and by brief to the foregoing authoritative statements of the law, deliberately ignored them and assumed the right to deny, not only to petitioners, but also to all other applicants in like case, the benefits conferred by the statutes with respect to the right of asserting and establishing priority over a rival claimant.

Abandonment.

It has been long-established law that abandonment of an invention is a matter for strict proof, and not of presumption.

Saunders v. *Miller*, 33 App. D. C., 456; 146 O. G., 505.

International Telephone Mfg. Co. v. *Kellogg Switchboard & Supply Co.*, 171 Fed., 651.

Rolfe v. *Hoffman*, 26 App. D. C., 336, p. 340; 121 O. G., 1350.

McDuffee v. *Hestonville M. & F. Pass. Ry. Co.*, 181 Fed., 503.

In the case of *Saunders* v. *Miller*, 33 App. D. C., 456, Saunders filed an application on February 24, 1905, for patent for an improvement in rubber footwear and a process of making the same, in which he illustrated and described the apparatus involved in the interference, but only claimed the process of making rubber footwear by the use of the apparatus. In the application he made the following statement:

> "the apparatus whereby my process is carried out forms no part of this invention, as any form of machine appropriate to accomplish all the steps above described may be employed."

Division was required, and on June 17, 1905, the applicant filed a divisional application claiming the product produced. On June 19, 1905, Miller filed his application for the invention of the issue. The Saunders original application with claims for the proces was allowed and became forfeited on April 16, 1906, for failure of payment of the final government fee. On April 17, 1906, Miller's patent was issued without interference. On September 8, 1906, Saunders renewed his original application, and on January 10, 1907, he filed a new application in which he copied the drawing and description of his original application and included in it the claims of the Miller patent. The interference was then declared. The Court of Appeals, D. C., in deciding the case, said:

> "There was a complete disclosure and reduction to practice of the invention in 1904. Conceding for the moment that the statement in the process application could be held to constitute abandonment, it would be an abandonment to the public, and not to appellee, since it occurred before appellee came into the field. The record discloses undeniably that appellant, and not appellee, is the real inventor of the device in issue. The disclosure and reduction to practice was followed by experiments as to its utility through the succeeding two years. The finding

of the Patent Office that appellant's apparatus of 1904 was nothing more than an abandoned experiment, is not supported by the record, and with this suggestion as to our view on this point, it will be dismissed without further consideration.

"This invention, therefore, belongs either to appellant or to the public. As before intimated, if abandonment can be established, it must be predicated upon acts of appellant committed before appellee came into the field. In that event, in the state of this record, it would inure to the benefit of the public, and not to appellee. Appellant was making experimental tests of the product of his invention, though in a somewhat public manner, by having the boots worn by the men in the employ of the company with which he was connected, but this is not sufficient to constitute a dedication to public use. Some manifest intention must be shown on the part of appellant to abandon his invention. . . .

"**Abandonment is never presumed. On the other hand, the presumption is against abandonment, and the burden is on the one charging it to establish it by clear and convincing proof.** (*Computing Scale Co.* v. *Automatic Scale Co.*, C. D., 1905, 704; 119 O. G., 1586; 26 App. D. C., 238; affirmed in C. D., 1907, 687; 127 O. G., 849; 204 U. S., 609.) It is likewise the law that where the evidence raises a presumption of abandonment, it may be rebutted by showing acts assertive of the inventor's right and his intention, by experiment or improvement, to perfect his discovery. It is generally held that where an inventor applies for and receives a patent which discloses another unpatented invention not claimed, that it is presumed not to be novel, or is dedicated to the public by the patentee. (*In re Millet*, C. D., 1901, 410; 96 O. G., 1241; 18 App. D. C., 186.) This presumption is rebutted if the patentee has another application, pending in the Patent Office claiming it (*Miller* v. *Eagle Mfg. Co.*, C. D., 1894, 147; 66 O. G., 845; 151 U. S., 186), or if he files such application promptly (*Dederick* v. *Fox*, C. D., 1893, 401; 63 O. G., 1963; 56 Fed., 714). We think appellant comes within the latter class."

Saunders v. *Miller*, 33 App. D. C., 456 (146 O. G., 505).

The law as to abandonment or estoppel in favor of the public is stated by the Circuit Court of Appeals for the Seventh Circuit, as follows:

> "Abandonment or dedication to the public: This contention centers on Dean's intent, *and the burden was on appellant to prove very clearly that Dean meant to donate his invention to the public. Ide* v. *Trorlicht Co.,* 115 Fed. 144, 53 C. C. A. 341, and cases there collated. Within the two years preceding the application there was no public sale or use and no publication under circumstances from which an inference of dedication might be drawn. And the positive evidence leaves no doubt that Dean intended to retain the invention as his own property until he could market it to his profit, as he did in 1901.
>
> "Equitable estoppel: Dean was the first and true inventor of the device in suit. There being no abandonment, no public use or sale, and no publication within the terms of section 4886, Rev. St. (U. S. Comp. St. 1901, p. 3382), his right to the patent is not assailable on statutory grounds. So far as equities are concerned, Dean, in spite of his delay, was the first to put the device into commercial use and the first to apply for a patent. If, during Dean's suspension of activities, McCormick had either patented the device or brought it into public use without a patent, the public would have been indebted to McCormick for benefits conferred, and Dean might well be held estopped by his delay from claiming the public grant; but in our judgment neither reason nor authority sanctions an estoppel against the first and true inventor unless the later comer has cut in between and made the public his debtor by being the first to get to the Patent Office or the market. *Kendall* v. *Winsor,* 21 How. 328, 16 L. Ed., 165; *Consolidated Fruit Jar Co.* v. *Wright,* 94 U. S. 92, 24 L. Ed. 68; *Savary* v. *Lauth,* Fed. Cas. No. 12,389; *White* v. *Allen,* Fed. Cas. No. 17,535. The decision in *Universal Adding Mach. Co.* v. *Comptograph Co.,* 146 Fed. 984, 77 C. C. A. 227, is to the same effect, when the general expressions are read, as they should be, in the light of the particular facts."
>
> *International Telephone Mfg. Co.* v. *Kellogg Switchboard & Supply Co.,* 171 Fed. Rep., 651, p. 656.

In the case at bar Chapman and Chapman were not only the first to get into the Patent Office, but were also the first to get into the market and to disclose the invention to the public, as they could prove if necessary.

In the case of *Rolfe* v. *Hoffman* the Court of Appeals, D. C., in an opinion by Mr. Justice Duell, said:

> "It is true that two years elapsed between his alleged reduction to practice and the filing of his application for patent, during which interval his rival entered the field and secured a patent. Such a period of delay, standing by itself does not constitute an abandonment of his right to a patent based on priority of invention. An inventor having reduced his invention to practice **is entitled to a period of two years in which to put the same in public use and on sale without a forfeiture of his right to receive a patent** based upon an application filed before the statutory bar has arisen. **Neither abandonment nor forfeiture within that period can be presumed but must be proven.**"
>
> *Rolfe* v. *Hoffman*, 26 App. D. C., 336 (p. 340); 1906 C. D., 588 (121 O. G., 1350).

The case of *McDuffee et al.* v. *Hestonville, M. & F. Passenger Ry. Co.*, 181 Fed., 503, decided by the Circuit Court for the Eastern District of Pennsylvania, is interesting and pertinent. In that case the third and fourth clauses of the syllabus are as follows:

> "3. An abandonment of an invention after the filing of an application for a patent, upon which a patent was subsequently granted, *must be established by clear proof showing an intention to abandon*, especially where the invention is a meritorious and valuable one.
>
> "4. *A patent cannot be defeated or limited by intervening rights of third persons applying for and receiving patents between the filing of the application and the issuing of such patent, where there was*

no abandonment of either the application or invention, and no expansion of claims, merely because there was delay in prosecution of the claims, which was satisfactorily explained to the Patent Office."

It appears that the application of Schlesinger, the patentee, was finally rejected *in toto* on October 17, 1887, as being anticipated by the prior art, and then lay dormant from 1887 until December, 1894, when application was made for the revival of the application on the ground that the delay was unavoidable, which application was ultimately granted and a patent issued. In considering the question of abandonment the court says:

"This finding is conclusive upon this court and establishes the fact that the application for the patent in suit had not been abandoned. An abandonment of an application for a patent is one thing and an abandonment of the inventions which the application seeks to have patented is another. And the defendants urge that, notwithstanding the action of the Patent Office justifying the delay in the prosecution of the application, the invention embodied in the combination of claim 1, as finally allowed, was abandoned. A patentable invention may be abandoned actually or constructively. With the subject of constructive abandonment the court has nothing to do in this case. Generally speaking, an actual abandonment of the invention may be by express declaration or by circumstances evincive of an intention to abandon. No express abandonment of the invention embodied in the combination of claim 1 has been shown. If there was an actual abandonment in or after October, 1887, it must rest upon circumstantial evidence clearly establishing the fact. No room should be left for substantial doubt on the point. Especially is this true in view of the meritorious character of the invention and the facts that until October, 1887, all due diligence was observed in prosecuting the application, and no conceivable reason appears why the invention should have been abandoned at or after that time. In *McMillin* v. *Barclay*, Fed. Cas. No. 8,902, Judge McKennan in dealing with this subject said:

"'Nor has the second branch of the defense, that the invention was actually abandoned, any better foothold. This must result from the intention of the patentee, expressly declared, or fairly indicated by his acts. There is certainly no evidence in the case of any express declaration of the patentee to that effect; and, if the lapse of years between the date of his application and of his patent, and his own conduct, can be fully explained upon any other hypothesis, they ought not to be imputed to an intention on his part to abandon his invention. The proof of actual abandonment, after application filed, ought to be indubitably clear. It ought not to rest upon doubtful or disputable inferences.'

"Here the record does not disclose any actual intention to abandon or any act or declaration of abandonment or any consent to the appropriation or use by others of the invention. In the absence of any evidence of a positive intention to abandon, I find it impossible to reconcile the fact, conclusively established by the decision of the Commissioner of Patents, that the application for a patent for the invention was not abandoned, with any theory that the invention must be presumed from the explained and justified delay to have been abandoned. The conclusion reached on this branch of the case is that the invention embodied in claim 1 of the patent in suit was not at any time abandoned."

McDuffee v. *Hestonville, M. & F. Pass. Ry. Co.*, 181 Fed. Rep., 503, pp. 511-12.

This case was subsequently reversed by the Circuit Court of Appeals for the Third Circuit by a decision reported in 185 Fed., 798, but the reversal was on other grounds.

Furthermore, in the case of *Frost* v. *Chase*, the Court of Appeals, D. C., held that, there being no concealment of the invention, the question of laches was not pertinent to the issue of priority of invention. We quote as follows:

"There being no concealment of the invention, *the*

question as to whether Chase has been guilty of laches is not pertinent to the issue here involved, nor is the question of intervening rights one that Frost may raise in this proceeding. (*Norling* v. *Hayes, ante,* 347; 166 O. G., 1282; 37 App. D. C., 169.)"

Frost v. *Chase,* 37 App. D. C., 179 (p. 183).

In the case at bar, also, there has been no concealment of the invention, since Chapman and Chapman not only filed their application for patent, but also, if permitted to do so, could show that they were the first to put the invention into actual practice in this country. The fact that they introduced their invention into public use and filed an application for patent therefor is inconsistent with the theory of suppression. The decision of the same court in *Meyer* v. *Sarfert* clearly states the law. In that case the court said:

"It is argued that Sarfert concealed his invention, and that his case therefore should be governed by the decision in *Mason* v. *Hepburn* (C. D., 1898, 510; 84 O. G., 147; 13 App. D. C.). It is true that he may have concealed it for a little time, but it is very plain *that he soon gave it to the public in the way of the result of its operation,* and that he showed it to his opponent Meyer early in 1899. This is inconsistent with the theory of suppression of the invention to which effect was given in the case of *Mason* v. *Hepburn.*"

Meyer v. *Sarfert,* 21 App. D. C., 26 (p. 29); C. D., 1903, 529 (102 O. G., 1555).

The rule announced in the Rowntree-Sloan case and in the case at bar is inconsistent with all the foregoing established rules of law, and, if valid, its enforcement will revolutionize the long-established practice of the Patent Office.

It has always been the settled policy of the patent laws of this country to reward the first inventor who

has availed himself of the rights and privileges conferred by those laws to disclose his invention to the public and obtain patent protection therefor. The Rowntree-Sloan rule, however, is not in harmony with that policy, but imposes a grievous burden upon inventors in that it requires them, especially after making application for letters patent, to critically examine the claims of each and every patent that may be issued from time to time relating to the arts in which their inventions respectively belong, in order that if any such patent perchance contains a claim that might interfere with the invention sought to be covered by an applicant, he may introduce it into his application for purposes of interference before all right of the applicant to such claim shall have been forever lost. The fact that the Official Gazette now publishes only fragmentary drawings and only one of the claims of most patents makes this burden practically insupportable.

Until the decision in the Rowntree-Sloan case, presumptive abandonment of an *invention* was in no case predicated on inaction short of two years, and the Court of Appeals evidently overlooked the well-settled rule of law that until an application matures into a patent no presumption of abandonment arises as to any subject-matter shown and described therein but not claimed. This is manifest from the reference by the court to the statute relating to the amendment of applications. Section 4894 provides that failure of an applicant to prosecute his application within *one* year after any action therein, of which he shall have received notice, shall work an abandonment of the *application*, but it is well settled that such failure does not work an abandonment of an *invention*, and if a statutory bar has not intervened, the applicant may file a new application and obtain a valid patent.

In the case of *Western Elec. Co.* v. *Sperry Elec. Co.* the Circuit Court of Appeals for the Seventh Circuit, Mr. Chief Justice Fuller and Circuit Judges Woods and Jenkins sitting, stated the law as follows:

> "There is a material difference between the abandonment of an invention and the abandonment of an application for letters patent thereon by failure to comply with section 4894 of the Revised Statutes. The first gives the invention to the public, and, once done, the act is irretrievable; but, besides the power conferred upon the commissioner of patents to relieve an applicant from an abandonment of his application under the statute, an application, which has lapsed, or been rejected or withdrawn, may be renewed or repeated so long, we suppose, as the invention itself has not been abandoned by reason of a two-years public use or otherwise."
>
> *Western Elec. Co.* v. *Sperry Elec. Co.*, 58 Fed., 186, p. 191.

To the same effect is the decision of the Circuit Court of Appeals for the Eighth Circuit in the case of *Hayes-Young Tie Plate Co.* v. *St. Louis Transit Co.:*

> "There is a wide difference between the abandonment of an invention and the abandonment of an application for it. An abandonment of an application is not necessarily an abandonment of the invention, and, after the application has been abandoned, a valid patent for the invention may nevertheless be secured upon a new application, provided the invention has not gone into public use or been upon sale for more than two years prior to the filing of the latter. In cases in which the first application has not been abandoned, subsequent applications and amendments constitute a continuance of the original proceeding, and the two years' public use or sale which may avoid the patent must be reckoned from the presentation of the first application, and not from the filing of subsequent application or amendments. *U. S.* v. *American Bell Telephone Co.*, 167 U. S. 224, 17 Sup. Ct. 809, 42 L. Ed. 144; *Colgate* v. *Western Union Tel. Co.*, Fed. Cas. No. 2,995; *Miehle* v. *Read*,

96 O. G. 426; *Thomson-Houston Electric Co.* v. *Winchester Avenue R. Co.* (C. C.), 71 Fed. 192, 73 O. G. 2155; *Godfrey* v. *Eames*, 1 Wall. 317, 17 L. Ed. 684; *Smith* v. *Goodyear Dental Vulcanite Co.*, 93 U. S. 486, 23 L. Ed. 952; *Cain* v. *Park*, 14 App. D. C. 42, 86 O. G. 797, 798; *Ex parte Stewart*, 4 O. G. 665; *Stirling Co.* v. *St. Louis Brewing Ass'n* (C. C.), 79 Fed. 80; *Dedrick* v. *Fox* (C. C.), 56 Fed. 714, 717; *Ligowski Clay-Pigeon Co.* v. *American Clay-Bird Co.* (C. C.), 34 Fed. 328, 333."

Hayes-Young Tie Plate Co. v. *St. Louis Transit Co.*, 137 Fed., 82.

The decision of the Court of Appeals for the Second Circuit in *Kinnear Mfg. Co.* v. *Wilson* is also in point:

"It is well settled that an inventor by describing an invention in a patent granted to him, does not preclude himself from patenting it subsequently. His omission to claim what he describes may operate as a disclaimer or an abandonment of the matter claimed; but it has no such effect when it appears that the matter thus described but not claimed was the subject of a pending application in the Patent Office by him for another patent. This was so decided by this court in *Thomson-Houston Electric Co.* v. *Elmira Railway Co.* (C. C.), 71 Fed. 396, and for other adjudications it suffices to refer to *Suffolk Co.* v. *Hayden*, 3 Wall. 315, 18 L. Ed. 76, and *Barbed Wire Case*, 143 U. S. 275, 12 Sup. Ct. 443, 36 L. Ed. 154."

Kinnear Mfg. Co. v. *Wilson*, 142 Fed., 973.

Again, applications which have been allowed and have become forfeited for failure to pay the final government fee, may be renewed at any time within two years after the allowance of the original application, and, as provided in Section 4897, upon the hearing of renewed applications, abandonment is considered *as a question of fact*. No *presumption* of abandonment arises from mere lapse of time, but must be established by proof.

In the case at bar the Court of Appeals does not hold that the Chapman and Chapman original application was abandoned by failure to prosecute it according to law, as there is no basis for any such contention. Neither does the court hold that Chapman and Chapman specifically abandoned the subject-matter incorporated in their divisional application. It clearly could not so hold, because, as shown by the record, their divisional application was filed while their original application was still pending, and, moreover, the claims made by Chapman and Chapman in their original application directed to the bearings of the pump shaft were withdrawn in deference to a requirement for division made by the Examiner, with a specific reservation that they would be incorporated in a divisional application. The Court of Appeals, however, goes further and holds that while the *application* was not abandoned, the *invention* which formed the subject-matter of that application was abandoned, and in support of this inconsistent position rules that the section of the statutes relating to abandonment of invention must be disregarded and that Section 4894, which merely relates to abandonment of applications, applies.

Abandonment of an *invention* is a much more serious thing than abandonment of an *application*. The Commissioner in his opinion referred to the question of reissue merely as showing by analogy that the courts in many cases have not regarded a delay of two years in applying for a reissue as establishing abandonment of the invention not claimed in the original patent, and in the same way he referred to Section 4886, which permits an applicant to file his application within two years after a patent has been granted to another for the same invention, or after it has been published, or put into public use, and works an abandonment of *invention* after a delay of two years.

His conclusion that

> "the diligence of one who, having already filed, copies its claims within two years of the granting of a patent, cannot be inquired into without imposing a condition more strict than is imposed by Sec. 4886 upon one who does not file his application until after the rival patent has been granted,"

is entirely sound, and shows that the rule announced by the court in the Rowntree-Sloan case was much more drastic than the provisions of Section 4886, or the rule applied in reissue cases, and therefore should not be adhered to. The application of that rule works an abandonment of the *invention*—not of the *application*, and, moreover, leaves the applicant no opportunity to explain or excuse his delay, which, in the case at bar, was only such delay as Section 4894 permits, and this notwithstanding the fact that where an applicant has allowed his application to become abandoned by failure to prosecute within one year, he is expressly permitted to excuse his delay, and by doing so to the satisfaction of the Commissioner, may revive his application. It is the prerogative of Congress to prescribe the rules of procedure governing applications for patents, and where Congress has spoken, the courts, it is submitted, cannot disregard the plain meaning of the statute.

The Court of Appeals is evidently desirous of expediting the prosecution of applications for patents, and what it considered to be an abuse of the privilege of amendment in the Rowntree-Sloan case was no doubt the motive which impelled it to the announcement of the ruling in that case; but, as pointed out by this court in the case of *U. S.* v. *Am. Bell Tel. Co., supra,* the views of any court as to the wisdom of a public policy instituted and approved by Congress and legally enacted are immaterial. The courts are bound to follow the law as it exists, and they have no authority to change it. In the case of *Bos-*

ton Store v. *American Graphophone Co. et al.*, decided by this court March 4, 1918, Mr. Chief Justice White in delivering the opinion of the court said:

> "Moreover, so far as the argument proceeds upon the assumption of the grave disaster which must come to the holders of patent-rights and articles made under them from the future application of the doctrine which the cases establish, it must be apparent that if the forebodings are real the remedy for them is to be found not in an attempt judicially to correct doctrines which by reiterated decisions have become conclusively fixed, but in invoking the curative power of legislation."
>
> *Boston Store* v. *Am. Graphophone Co. et al.*, 249 O. G., 985, p. 988; 246 U. S. 8 (pp. 25-6).

The rule announced in *Rowntree* v. *Sloan* and applied in the case at bar, being clearly in contravention of the statutes, should, therefore, be disapproved and overruled.

Estoppel.

An interference is a proceeding instituted for the sole purpose of determining the question of priority of invention as between the parties thereto. (*Lowry* v. *Allen*, 203 U. S., 476.)

It follows that matters of estoppel may be considered in an interference only in so far as they arise *inter-partes* and affect the question of priority. For example, if one of the parties has abandoned the invention to the public, either actually or constructively, that fact would not enter into the question of priority and could not be considered in an interference proceeding. (*Norling* v. *Hayes*, 37 App. D. C., 169, pp. 177, 178. *Slingluff* v. *Sweet & Spinasse*, 45 App. D. C., ——; 230 O. G., 659.)

In the case at bar, Chapman & Chapman being admittedly the first inventors of the issue, no question of estop-

pel *inter-partes* could arise which by any possibility could affect the question of priority of invention. Even if they had formally assigned the invention to Wintroath, that would not entitle him to priority, as he could not qualify under the statutes, since he did not conceive the invention until long after Chapman and Chapman's application was filed. But the Court of Appeals held that, because Chapman and Chapman did not introduce into their application the precise claims of the interference issue until one year and eight months after the Wintroath patent was issued, they were guilty of laches, and that such laches created an estoppel which conferred priority upon Wintroath and validated his obviously invalid patent,—a most remarkable innovation in patent law. The discussion of this subject in the opinion is somewhat inaccurate and confused. For example, the court says:

> "In support of this, (the claim of laches or estoppel) appellant points to our decision in *Rowntree* v. *Sloan*, 45 App. D. C., 207, where it was held that, in analogy to the time allowed by the statute for amendments to applications (R. S., Sec. 4894), a failure for more than one year to make a divisional application amounted to laches and barred its allowance."

In *Rowntree* v. *Sloan* there was no question of a divisional application and no such ruling was made. Sloan made the claims of the issue in his original and only application, but made them three years after the Rowntree patent was issued. Moreover, the question of laches or estoppel was not presented to the court in that case. It was raised in the original assignment of errors, but was withdrawn as untenable in the brief filed in behalf of Rowntree, and was not argued. The only point urged in behalf of Rowntree was that Sloan had no right to claim the issue because it was not disclosed in his application, and that point was sustained on the appeal. The court, however, *sua sponte* announced the theory of estop-

pel as a further ground for awarding priority to Rowntree. Clearly, therefore, the decision on the latter point was pure *dictum*.

Continuing the court says:

> "The Commisioner refused to follow the decision on that point, saying it was *obiter* and ruling that in his judgment the time should be two years instead of one, on the analogy of the statute which gives an inventor that length of time after a patent has emerged to another for his invention before it is necessary for him to file his own application. He therefore decided that the appellees were not chargeable with laches and awarded them priority. . . .
>
> "Nor do we believe that the two year rather than the one year period should prevail. *True, there is some resemblance between the divisional application of the Chapmans and an application of an inventor whose invention has been patented to another, but it is not as intimate as that which exists between their application and one for leave to amend.*" (Rec., p. 134.)

We confess our inability to follow the reasoning of the italicized portion of the foregoing quotation. Chapman and Chapman's divisional application was not one "for leave to amend," as the court seemed to think, but was a regularly pending application, filed in response to a ruling of the Examiner and conforming strictly to the rules and practice of the Patent Office as they have existed for generations, and the claims of the interference issue were made in the divisional application as filed so that there was never any motion "for leave to amend." Furthermore, the case at bar is *precisely* the case "of an inventor whose invention has been patented to another," instead of one having "some resemblance" to such a case. That the court considered Chapman and Chapman to be applicants for "leave to amend" is further evident from the statement in the opinion that "Their application, *if granted*, would be in the nature of an amendment

to their parent application and would date back to it (*Lotz* v. *Kenney*, 31 App. D. C. 205)." Their divisional application was regularly filed and *did*, under the rules and practice, date back to the date of their parent application. The "if granted" of the opinion shows that the court entirely misconceived the facts and the law, and supposed that Chapman and Chapman were asking leave to file a divisional application; that it has the jurisdiction and authority of a court of equity to consider and determine whether or not they were equitbly entitled to file such application, and that it was competent for it to base an award of priority of invention on a supposed estoppel which had no relation whatever to that question.

The decision of the Court of Appeals in this case is further unwarranted and unsound because it imposes upon applicants for patents a duty which is distinctly imposed by statute upon the Commissioner of Patents.

Sec. 4904, Rev. Stat., which provides for the declaration of interferences, specifically directs that the Commissioner *shall give notice* to the applicants whenever an application is made for a patent which *in his opinion* would interfere with any pending application, *or with any unexpired patent*, and provides that *he* shall thereupon direct the primary examiner to proceed to determine the question of priority of invention. The statute does not charge an applicant with the duty of determining whether or not in *his* opinion the invention for which he seeks a patent conflicts with any other pending application or unexpired patent, but specifically *imposes that duty upon the Commissioner*, and requires that notice shall be given not only to the applicants, but to the patentee also in the case of an unexpired patent.

This precise question was considered by this court in the recent case of *Ewing* v. *U. S. ex rel Fowler Car Co.*,

the opinion in which fully sustains our contention. In that case the court said:

> "The mere fact of asserted antagonism does not put the proceedings in motion, is the contention. There must be the precedent and superintending judgment of the Commissioner. The law requires, it is said, his opinion to be exercised upon the effect of a conflict in applications, and such indeed is the language of Sec. 4904. It provides that 'whenever an application is made for a patent which, *in the opinion** of the Commissioner, *would interfere with any pending application** . . . . he shall give notice thereof . . . . and shall direct the primary examiner to proceed to determine the question of priority of invention.' . . .
>
> "If it could be conceded that there is antagonism between §4904, and the rules, the former must prevail. *Steinmetz* v. *Allen,* 192 U. S. 543, 565. But there is no antagonism. The former provides that 'whenever an application is made for a patent which, *in the opinion** of the Commissioner, would interfere with any pending application . . . . . he shall direct the primary examiner to proceed to determine the question of priority of invention.' The section, therefore, commits to the opinion (judgment) of the Commissioner the effect of an application upon a pending one—whether it will interfere with a pending one; something more, therefore, than the fact of two applications, something more than the mere assertion of a claim. The assertion must be, in the opinion of the Commissioner, an interference with another. And it is this other that is first in regard, not to be questioned except at the instance of the Commissioner by an exercise of judgment upon the circumstances."
>
> *Ewing* v. *Fowler Car Co.,* 244 U. S., 1 (pp. 8 and 10).

The Court of Appeals, however, disregarding the plain terms of the statute, holds that applicants are charged with constructive notice of all the claims of

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* The italics are in the text.

all unexpired patents; that it is an applicant's duty to discover whether or not any such claims interfere with the invention for which he seeks a patent, and that his failure to make such claims within one year after the patent containing them was issued constitutes laches which forever estops him from making them. In other words, the Court of Appeals holds that an applicant is to be adjudged guilty of laches because of the failure of the Commissioner to perform a duty with which he is expressly charged by law, and this on a theory of constructive notice plainly in conflict with the law. As we have shown, section 4904 specifically provides that the Commissioner *shall give notice* in interference cases, and obviously it is not competent to nullify the statute by a theory of *constructive* notice. Moreover, Sec. 4900, Rev. Stat., requires patentees and all persons making or vending any patented article for or under them to give sufficient notice to the public that the same is patented by appropriate marking of the patented article, so that evidently the law does not charge the public with constructive notice of the scope of patented claims.

The theory of constructive notice applied in the case at bar is peculiarly inequitable and unjust because the Wintroath application was filed while the Chapman and Chapman application was pending under prosecution in the Patent Office, and the patent was issued to Wintroath without any notice having been given them of interfering subject-matter. To charge Chapman and Chapman with laches based on constructive notice of a patent inadvertently issued during the pendency of their application is, therefore, to penalize them for the mistake of the Patent Office, since, relying on the statutes and the rules of the Office, they had every right to assume that during the pendency of their application

no patent would issue for interfering subject-matter. It has long been established law that a patent issued inadvertently has no other or better standing for purposes of interference than a pending application, and it logically follows that an applicant can no more be required to make the claims of an inadvertently issued patent within any arbitrary time limit not authorized by statute than he can be required, *without notice,* to make the claims of a copending application within such an arbitrary time limit. The present practice of the Patent Office provides for suggesting claims to an applicant with notice that such claims must be made within a certain time, in default of which the applicant will be considered to have disclaimed them, but in all such cases the claims suggested are presented to the applicant *so that he has notice of them.* This was *not* done in the case at bar. It is submitted, therefore, that there is absolutely no justification for the charge of laches against Chapman and Chapman, even if it were material to the question of priority.

The rule announced by the Court of Appeals in the Rowntree-Sloan case is judicial legislation because it in effect amends the statutes, and particularly Sec. 4904, by fixing an arbitrary time limit within which an applicant must make the claims of an unexpired patent if he desires an interference with the patentee. The statute says "*any unexpired* patent," but the Court of Appeals says "any patent issued not more than one year before the applicant made the claims thereof," and attempts to justify the one-year limit by analogy to the law relative to amendment of applications. We have shown that there is no analogy between the two situations, since the effect of the Rowntree-Sloan rule is to work an abandonment or absolute forfeiture of the *invention,* whereas failure to amend merely works the

abandonment of the *application*, with a possibility of revival for good cause shown. Moreover, the Rowntree-Sloan rule undertakes, as in the case at bar, to transfer the quality of first inventorship from the actual first inventor to a junior inventor who cannot qualify under the statutes. As the statutes confer the right to a patent only on the first inventor, only Chapman and Chapman may lawfully obtain a patent for the subject-matter of the issue, and there is no authority for divesting them of that right and transfering it to a confessedly later inventor merely because they did not define their invention in some particular phraseology before the expiration of an arbitrary time limit. If Chapman and Chapman lost their right to a patent by failing to make certain specific claims within one year or any other period, they lost it to the public and not to Wintroath, as he, having admitted that he was not the first inventor, stands in no different or better relation to the invention than the rest of the public. It follows that Chapman and Chapman owed no duty to him, and consequently no estoppel in his favor could arise through any delay on their part in making the claims of the issue.

Counsel for Wintroath complain that the grant of a patent to Chapman and Chapman would interfere with the business which the owners of the Wintroath patent have entered upon, and in which they allege they have expended considerable money. The answer to this complaint is, *first*, it has nothing whatever to do with the question of priority of invention; *second*, there is no evidence sustaining counsel's allegations, which are based merely on Wintroath's preliminary statement (Rec., p. 55), but Patent Office Rule 117 specifically provides that "the preliminary statement can in no case be used as evidence in behalf of the party making it";

third, the grant of a patent conveys no right to use, but merely the right to exclude, and therefore Wintroath had no right to assume that the grant of a patent to him authorized him to use the invention described therein; *fourth,* according to counsel's own statement, the owners of the Wintroath patent embarked in the business in May, 1912, but did not file their application until December, 1912, and their patent was issued in November, 1913, so that they had been in the business for a year and a half before the Winroath patent was issued. In engaging in such business Wintroath's assignee took only the chances that every other manufacturer takes who engages in manufacturing; *fifth,* the public does not owe its knowledge of the invention to Wintroath, or his assignee, but rather to Chapman and Chapman, as they are ready to prove if necessary, and it is not unlikely that Wintroath had full knowledge of what they had done before he entered the field.

Second Question.

On an interference appeal from the Patent Office under the Act of February 9, 1893 (27 Stat. L., 434, Ch. 74), is the jurisdiction of the Court of Appeals of the District of Columbia confined to a determination of the question of priority of invention, and may the question of whether a statutory bar exists to the grant of a patent to the actual first inventor of the subject-matter of the issue be determined on such appeal?

This precise question was answered in the negative by this court in *Lowry* v. *Allen* as follows:

> "The statute is explicit. It limits the declaration of interferences to the question of priority of invention. Section 4904 provides that in case of conflict of an application for a patent with a pending application or with an unexpired patent (as in the

case at bar), the Commissioner shall give notice thereof, 'and shall direct the primary examiner to proceed to determine the question of *priority of invention*' . . . We concur with the views expressed, that the statutes provide only for appeals upon the question of priority of invention. Appeals on other questions are left to the regulation of the Patent Office under the grant of power contained in Section 483."

Lowry v. *Allen,* 203 U. S., 476 (p. 482).

Obviously the existence of a statutory bar has nothing to do with the question of priority, and the Court of Appeals has itself repeatedly so held. See:

Norling v. *Hayes,* 37 App. D. C. 169 (pp. 177-178), and cases therein cited.

Slingluff v. *Sweet & Spinasse,* 45 App. D. C., —; 230 O. G. 659.

Frost v. *Chase,* 37 App. D. C. 179.

The Court of Appeals, however, attempts to distinguish the instant case from one involving a statutory bar on the ground that a question of laches and not one of a statutory bar is here involved, and by way of illustration cites a supposititious case. We quote as follows from the opinion (Rec., p. 135):

"The dispute in an interference case is in respect to which one of the disputants is entitled to priority concerning a given alleged invention (*Foster* v. *Antisdel,* 14 App. D. C. 552, 555; *Prindle* v. *Brown,* 24 App. D. C. 114). Let us suppose that A and B are the contestants. If it be held that as between them A conceived and reduced the invention to practice in 1915, but that B never thought of it until 1916, it would profit B nothing to show that A could not secure a patent for the invention, either because it was not patentable, or his right to a patent was barred by the statute of public use, or for any other reason. Therefore such a showing would be immaterial. These infirmities in A's situation would present questions between him and the

> Patent Office in which B as an applicant would have no interest whatever. They would arise in a proceeding different from an interference proceeding, and one in which the parties were not the same. Consequently our holdings that the bar of the statute of public use, lack of patentability and similar questions are not justiciable in an interference proceeding, is in no way inconsistent with the holding that laches is."

The court was unhappy in its illustration, as its suppositious case is precisely the case at bar, and therefore by the court's own reasoning it had no jurisdiction.

It was not contended in the court below that laches could not be considered in an interference *where it went to the question of priority*, as the court seems to suppose. We fully agree that in such cases it is quite material, but in the case at bar the question of priority is foreclosed by Wintroath's admission in his preliminary statement that he did not conceive the invention until long after Chapman and Chapman had filed an application for patent fully disclosing and broadly claiming it. In such a state of facts, as this court held in the case of *Ewing* v. *U. S. ex rel. Fowler*, 244 U. S. 1 (p. 9)

> "If there are such possibilities in some interferences they are precluded in petitioner's case. . . . The conceptions were thus established to be identical and that that of Fowler did not come to him until some months after the filing of the other application. And it is to be observed that the *priority was complete.*"

The Court of Appeals in the opinion filed refers to a number of cases in which ancillary questions were considered in interferences, but in each of the cases cited such questions had a direct bearing on that of priority. The court, as is apparent from the summary of such cases in the opinion, failed to appreciate the distinction between laches in completing an invention, and aban-

donment of a completed invention. Chapman and Chapman having reduced their invention to practice by filing their application for patent before Wintroath conceived the invention, laches could not enter into the question of priority as between the parties. Indeed, there could be no question of priority between them. The only question was whether or not Chapman and Chapman had abandoned the invention to the public. They certainly could not abandon it to Wintroath because he could not qualify under the statute as the first inventor. If Chapman and Chapman had not abandoned the invention they were entitled to their patent, regardless of Wintroath's patent, and Wintroath does not enter into that question at all.

The decision of the Court of Appeals, therefore, in effect holds that that court has jurisdiction to consider the question of the statutory bar of abandonment on an interference appeal, notwithstanding the ruling to the contrary of this court in *Lowry* v. *Allen, supra.*

In *Bate Refrigerating Co.* v. *Sulzberger,* this court said:

> "If Section 4887 of the Revised Statutes is so worded as to express clearly the intention of Congress, the court must give effect to that intention. But even if the statute be not so explicit as to preclude construction; if upon applying to it the established rules of interpretation; if looking at it in the light of previous legislation on the subject; if there be reasonable ground for adopting either one of two constructions; this court, without departing from sound principal, may well adopt that construction which is in harmony with the settled practice of the executive branch of the government, and with the course of judicial decisions in the Circuit Courts of the United States; especially, if there be reason to suppose that vast interests may have grown up under that practice and under judicial decisions,

which may be disturbed or destroyed by the announcement of a different rule."

Bate Refrigerating Co. v. *Sulzberger*, 157 U. S. 1 (p. 34).

The foregoing remarks apply specifically to the case at bar. The fact that the Patent Office and the courts have for more than forty years harmoniously interpreted and applied the statutes bearing upon the facts of this case is sufficient ground for assuming that the practice so established is sound and should not be overturned.

The rule which the Court of Appeals undertook to establish in the Rowntree-Sloan case, and which it applied in the case at bar, being clearly in contravention of the statutes and of the long established practice of the Patent Office and of the courts, and being moreover in direct conflict with the decisions of this court in *U. S.* v. *Am. Bell Telephone Co.; Lowry* v. *Allen; Ewing* v. *U. S. ex rel. Fowler*, and *Boston Store* v. *Am. Graphophone Co.* should accordingly be disapproved and set aside, the judgment of the Court of Appeals reversed, and the cause remanded with directions to enter judgment of priority in favor of Chapman and Chapman.

Respectfully submitted,

JOHN L. JACKSON,
ALBERT H. ADAMS,
Counsel for Petitioners.

Chicago, September, 1919.

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IN THE

Supreme Court of the United States.

October Term A. D. 1919.

MATTHEW T. CHAPMAN and
MARK C. CHAPMAN,
Petitioners,

vs.

JOHN A. WINTROATH,
Respondent.

BRIEF IN BEHALF OF RESPONDENT.

Statement of the Case.

This cause comes up by writ of certiorari directed to the Court of Appeals of the District of Columbia, and it relates to an interference between an unexpired patent and a pending application for patent filed at a relatively late date and containing claims copied from the issued patent for the purpose of demanding an interference.

Respondent does not subscribe to the Petitioner's statement of the questions of law involved, but states that the following correctly represents the real issues of law:

QUESTIONS INVOLVED.

1. Is a patentee who has been in undisturbed possession of his duly granted rights for a period of years to be deprived of said rights by a rival inventor who, although the earlier to file an application disclosing, inter alia, the subject matter of said patent, never claimed the said subject matter until twenty months after the issue of the said patent, at which time, over six years after his original filing date, he filed an alleged divisional application for the purpose of copying therein claims from the said issued patent directed to such subject matter, and is such an applicant to be rewarded by the grant of a *second patent* on the same subject mater which will have the effect of *extending the monopoly to which the public has already been subjected* for a considerable period by the grant of the first patent; or is the applicant guilty of laches such as debars him from asserting a claim of prior inventorship; the lack of diligence being further aggravated by the fact that the invention was admittedly put into public use by the applicants (Chapman & Chapman) before they even filed their original application?

(In the opinion complained of, the Court of Appeals, D. C., applied a one year rule as a measure of diligence in such a case, in analogy with the statutory rule requiring amendment of an application within one year after the receipt of Office Action.)

2. Is the jurisdiction of the Court of Appeals of the District of Columbia on appeals in Interference contests limited to a determination of the question of priority as between rival inventors strictly from the standpoint of time only, or may it consider and determine ancillary matters such, for example, as diligence and laches as affecting priority of invention in law?

The Court of Appeals held it was not so limited and could consider such ancillary questions. Inasmuch as the opinion of the Court of Appeals (Rec., p. 101) clearly disposes of this second question no argument will be presented, attention being merely directed to the aforesaid opinion.

SUMMARY OF FACTS.

The following is a brief statement of the history of these contestants in the Patent Office:

Chapman & Chapman

Original application filed March 10, 1909	Invention in issue disclosed *but not*
Patent thereon issued August 10, 1915	*claimed.*
Divisional Application filed July 6, 1915	Copied claims from Wintroath's patent (Twenty (20) months after Wintroath's issue date).

Wintroath

Application filed December 2, 1912.
Patent issued November 25, 1913.

Chapman & Chapman admitted (see Opinion of Commissioner Record, page 83) that it was not until July 6th, 1915, when the divisional application was filed, that they made any claims approximating those in issue—over six years after the filing date of their original application and twenty months after Wintroath's patent issued.

The subject matter of the interference is defined in claims 2, 3 and 4 of the Wintroath patent and in claims 1, 2 and 3 of the Chapman & Chapman Divi-

sional Application. It is unnecessary to consider these claims in detail. The device is a deep well pump and the claims are directed to the combination with the power shaft or pump shaft of a fluid pressure operated bearing which supports said shaft, an auxiliary bearing for sustaining the downward thrust of the power shaft, and an auxiliary bearing to receive the upthrust of the shaft.

On March 21st, 1916, the Interference was declared between the Chapman & Chapman divisional application, Ser. No. 238, 254 and the Wintroath patent (Record, pages 53 and 54) the declaration coming two years and four months after the date of the issue of the Wintroath patent.

The usual preliminary statements were filed by both parties and, Wintroath's conception of the invention being later than the filing date of the original Chapman & Chapman application, Ser. No. 482,517, the Examiner of Interferences, in accordance with Rule 114 of the Patent Office, on May 5, 1916, served notice that Judgment on the Record would be entered against Wintroath unless he should, within thirty days, show sufficient cause why such action should not be taken (Record, page 56).

On June 21, 1916, Wintroath moved for Judgment on the Record in his favor on the ground that in view of the facts of the case "Chapman & Chapman must "be held to be estopped to make the claims in issue, "and to have abandoned any right which they may "have once had thereto, and in addition it would be "against public policy and the spirit of the patent "law to permit Chapman & Chapman at this late date "to deprive Wintroath of the fruits of his diligence "and thereby permit an unlawful extension of the "patent monopoly on the invention. (Record, pages 62 and 63.)

The motion was based on a decision of the Court of Appeals of the District of Columbia in the case of Rowntree vs. Sloan (277 O. G. 744; 45 App. D. C. 207), in which it was held that

> "Sloan's laches, in failing within a reasonable time after the issuance of the Rowntree patent to make his claims, estopped him to make them at all afterwards. If he thought these claims read upon his application, it was his duty promptly to make them; at least within the time allowed for amendment after office action (one year), and his failure to do so is fatal to his present contentions."

The Examiner of Interferences, in an opinion dated July 8, 1916 (Record, pages 72, 78) followed the doctrine announced in Rowntree vs. Sloan and awarded priority to Wintroath.

An appeal was then taken by Chapman & Chapman to the Board of Examiners in Chief, who, in an opinion dated November 18, 1916 (Record, pages 80 and 81) also followed Rowntree vs. Sloan and affirmed the decision of the Examiner of Interferences.

Chapman and Chapman then appealed to the Commissioner in person, who in an opinion (Record, pages 82 to 86) reversed the Board of Examiners in Chief, holding a two year rule of diligence was controlling.

Wintroath then appealed to the Court of Appeals of the District of Columbia (Record, page 88) and the Court of Appeals in an opinion by Mr. Chief Justice Smyth (Record, pages 164 to 167) reversed the Commissioner of Patents and awarded priority to Wintroath, modifying the ruling in Rowntree vs. Sloan to a one year rule of diligence *unless the applicant could give satisfactory reasons justifying a longer delay.*

Thereafter Chapman & Chapman petitioned this Honorable Court for a *writ of certiorari* which was granted.

SUMMARY OF ARGUMENT.

1. While the patenting of an invention is purely Statutory, the Statute has been uniformly construed in the light of the underlying purpose of the patent system—the promotion of the progress of science and the useful arts.

Kendall vs. Winsor, 21 How. 322-328, and cases cited in following paragraph.

2. Diligence is axiomatic and there is a time limit within which claims to a particular invention shown, but not claimed in an application, may be added.

Ex Parte Dyson, 232 O. G. 755.
In re Fritts, 45 App. D. C. 211.
Victor Talking Machine vs. Edison, 229 Fed. 999.
Christensen vs. Noyes, 15 App. D. C. 94.
Bechman vs. Wood, 15 App. D. C. 484.
Skinner vs. Carpenter, 36 App. D. C. 178.

3. The Statute itself lays down a *pre*-application rule of diligence and a *post*-application rule.

See Secs. 4886 & 4887, and Sec. 4894 R. S.

4. Where an applicant has an application showing, *inter alia*, but not at any time claiming a particular feature pending in the Patent Office for years he should proceed at least within one year after the issuance of a rival patent for the same invention, to copy claims therefrom for the purpose of an Interference, by analogy with Sec. 4894 R. S.

5. The issue of a patent is constructive notice to the public of its contents.

Boyden vs. Burke, 14 How, 575-83.

6. If Chapman & Chapman's divisional application be considered independently of the present application, they are out of Court in their own admission of a prior public use of more than two years.

See Brief, pp. 13 and 14.

If considered as a continuation of the parent application, *post*-application rules of diligence apply and they are guilty of lack of diligence.

7. Chapman & Chapman were never "regularly" prosecuting an application for the invention, and there is no basis in the Statute or authority for the proposition that the mere presence of a drawing or description of a feature in an application constitutes a reduction to practice thereof such as will defeat a later inventor but earlier patentee.

Pittsburgh vs. Beler, 228 Fed. 683.
Saunders vs. Miller, 33 App. D. C. 456.

ARGUMENT.

There Is a Time Limit Within Which Claims May Be First Presented.

The patenting of an invention is a purely statutory proceeding, but while an applicant is entitled to all of the rights conferred by the Patent Statues, the Statutes have been uniformly construed in the light of the purpose underlying the entire patent system, which is to "promote the progress of science and the useful arts," that is to say, the public welfare.

Kendall vs. Winsor, 21 How. 322, 328, and other cases hereinafter cited.

Among other things, it has become axiomatic that the interests of the public, the real beneficiary of the patent system, are best served by the exercise of diligence in the prosecution of patent applications. The Patent Office now requires (Commissioners Order No. 2210 of July 6/15, 216, O. G. 1), that applications must be placed in condition for final action i. e. in condition for allowance and issue, or final rejection, within three years. See Appendix.

It is also generally recognized that, while the making of claims in a patent application is only one of a number of incidents to the patenting of an invention, there is a limit to the length of time within which claims directed to a particular feature or features of the invention described in the specification or to one or more of a number of different inventive thoughts disclosed, may be inserted into a pending, a renewal or a reissue application.

The reasons for the foregoing are given in the following selection of typical cases in point:

Ex Parte Dyson, 232 O. G. 755.
In re Fritts, 45 App. D. C. 211.
Victor Talking Machine Co. vs. Thos. A. Edison, Inc., 229 Fed. 999.
Christensen vs. Noyes, 15 App. D. C. 94.
Bechman vs. Wood, 15 App. D. C. 484.
Skinner vs. Carpenter, 36 App. D. C. 178.

In Ex Parte Dyson, *supra*, the Commissioner pointed out with reference to applications pending in the Patent Office for a period of years while other inventors are perfecting similar devices, that they

"are, in effect hidden traps for later inventors, who, without knowledge of their existence, in good faith produce similar inventions and apply for

patents, only to find their efforts anticipated and their labor lost. Patents granted are carefully examined by the owners of these old applications to see if some claim or claims of the patent can by arguable interpretation be predicated upon the structure of some one of these old cases. If this is found to be possible, the claim is presented in the old application and an interference is demanded. By reason of the old filing date an award of priority adverse to the patentee sometimes results and the Office is placed in the position of having issued a patent with invalid claims.

When these applications shall have finally issued into patents, many of them will, presumably, contain broad claims dominating better devices and mechanisms developed during the years of their pendency."

In the case of In re Fritts, *supra*, the Court of Appeals said:

"We frequently have had occasion to observe that inventors are quite prone to overlook the fact that the true policy and ends of the patent laws enacted under this government are disclosed in that article of the Constitution, the source of all those laws, viz. "to promote the progress of science and the useful arts,' contemplating and necessarily implying their extension and increasing adaptation to the uses of society. It was his duty, within a reasonable time after the issuance of those patents, to assert his claims thereto, to the end that an interference might be declared and the issue of priority determined. By failing to assert such claims he must be held to have abandoned them. When the element of *diligence* or *good faith* in an applicant is lacking, there is no valid reason for such a construction of the patent laws as would effect an extension of the limited monopoly granted upon prescribed conditions, which include those very elements. *Inasmuch as even diligence and good faith do not entitle one to a monopoly upon*

a monopoly, it is not perceived why delay and the lack of good faith should do so." (Emphasis ours.)

The Circuit Court of Appeals of the Second Circuit in the case of Victor Talking Machine Co. vs. Thomas A. Edison, Inc., *supra*, held with reference to an applicant who delayed while others independently developed the art along similar lines:

> "To let him reserve his patent till the trade independently develops and then to pounce upon it for a full term would seem to violate the conditions upon which his grant depends and to convert the system into a mere means of checking industry. * * * * The case certainly suggests a purpose to monopolize that invention still further by reserving in the Patent Office patents upon other similar machines known long before. Whether this be true or not, the practice is so obviously mischievous that the courts should discourage it as much as possible."

In *Christensen vs. Noyes, supra,* the Court of Appeals, District of Columbia, Noyes *renewed* a forfeited application and inserted therein claims from the Christensen patent which had issued in the meantime and demanded an interference, and among other things the Court decided that Noyes had not been diligent in filing his renewal, and therefore found against him.

In *Bechman vs. Wood, supra, the* same Court held that it was not permissible to add by amendment at a later date, broad claims, which dominated a specific structure which in the meantime had been patented to another.

In the case of *Skinner vs. Carpenter, supra,* the same Court held that a patentee who was not diligent in filing a *reissue application* containing claims inserted for the purpose of obtaining an interference with an-

other patentee, had lost his right to make the interfering claim.

The difficulty which presents itself in the determination of what is a reasonable length of time within which action should have been taken in this case is that no specific provision of the Statutes in terms directly takes care of such a situation. The Patent Office in the opinion (Record, page 83) of the Honorable Commissioner of Patents took the position that a two year rule of diligence is controlling by analogy with Section 4886 and Section 4897 of the Statutes (respectively found on pages 17 and 19 of petitioner's Brief herein), and by analogy with the two year broadened reissue rule, generally laid down by the Courts. Chapman & Chapman apparently contend for the rule announced by the Commissioner (see last paragraph of page 12 of petitioner's Brief herein).

On the other hand, Wintroath takes the position which was taken by the Examiner of Interferences, the Board of Examiners in Chief and the Court of Appeals that a one year rule of diligence should be controlling by analogy with section 4894 of the revised Statutes (printed on pages 18 and 19 of the Petitioner's Brief.)

One Year Rule of Diligence is Sound.

The Statute itself lays down a *pre*-application rule of diligence and a *post*-application rule of diligence. Thus, Sec. 4886 (printed in Petitioner's Brief, page 17) states that an inventor may obtain a patent by filing his application within *two years* of publication and public use or sale, *provided, however, the invention is not abandoned*; and Sec. 4887 (Petitioner's Brief, page 18) provided that "no patent shall be granted on an

application for patent for an invention" which had been published or in public use or on sale "more than two years before the date of the actual filing of the application" * * *

Section 4894, however (Petitioner's Brief, pages 18 and 19) requires a responsive amendment of a pending application within one year after receipt of office action unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable, in which connection it is very significant that theretofore the Statute (Sec. 4886 before the amendment of March 3, 1897) allowed two years for amendment.

Ordinarily a divisional application is deemed a continuation of the parent or original application and is in the nature of an amendment of the original and dates back to the original. (See *Lotz vs. Kenny*, 31 App. D. C. 205; *Von Reclinghausen vs. Dempster*, 34 App. D. C. 474, and the cases therein cited.)

The reason a divisional application is ordinarily given the benefit of the filing date of the parent application is that a presumption arises upon the filing of the latter of the *completion* of the invention shown and described and it is also because of this presumption of completion upon filing that the Statute requires a diligent prosecution of pending applications by limiting the time for responsive amendment to one year after Office action.

Now Chapman & Chapman had constructive notice not only by publication in the Official Gazette of the issue of the Wintroath patent containing the very claims of Interference, but also by the issue of the Patent itself (see *Boyden vs. Burke*, 14 How. 575-83), twenty months before the date of the filing of their divisional application, and they should at the very least have filed their divisional application within one year

after this notice that a rival was in the field. Stated in other words the issue of and the publication of the issue of the Wintroath patent should be considered as tantamount to an Office action and action or amendment on their part should have been taken within one year by analogy to Sec. 4894.

To hold otherwise would be to place Chapman & Chapman's divisional application in the category of an original application, which for reasons to be shortly pointed out is believed to be a construction, which, if accepted, is fatal to the Chapmans.

Chapman and Chapman must rely on their original application, that is to say they must rely on the divisional application as being a continuation of the parent application, for the reason that if this were not the case they could not make the oath to the divisional application required by the Statute, namely, that the invention had not been in public use more than two years before the date of execution of the divisional application and its filing.

In support of this we direct attention to the fact that Chapman & Chapman *admit* that they had the invention in public use and on sale, not only long before Wintroath's filing date (December 2, 1912, two years and seven months before the filing of their divisional application), but also *before* they even filed their parent application (March 10, 1909).

See admission contained in upper half of page 58 of Petitioners' Brief before this Honorable Court. Also page 44 of their Brief.

The language there used plainly refers to the same admission which was contained in Chapman & Chapman's Brief before the Board of Examiners in Chief, page 20, in the following language:

"Consequently it does not lie in the mouth of

Wintroath on this proceeding to deny that Chapman & Chapman's actual reduction to practice of the invention of the issue, and *their public use thereof, occurred prior to the filing not only of Wintroath's application but also of Chapman & Chapman's original application,* which facts must, for the purposes of this motion, be considered so proven." (Emphasis ours.)

From the above it must inevitably follow that if Chapman & Chapman's divisional application be considered independently of the parent application, i. e. in the category of an original application, as is contended by the Chapmans (Petitioner's Brief, page 10), then they are out of Court on their own admission that the invention had been in public use by them more than six years before the filing of their divisional application, and this public use is a bar to their obtaining a patent.

On the other hand, if the divisional application be considered as a continuation of the parent application, then logically it must follow that the diligence they must show is that which is reasonably to be expected from an inventor *after* his application has been filed, and what could be more reasonable than giving an applicant one year's time after the issue of a rival patent within which to copy claims from that patent, when such applicant has already had on file for four years and eight months prior to the issue of such rival patent, an application, which, while showing the invention in Interference never contained any claims directed thereto? This would give Chapman and Chapman a total of five years and eight months (5 years 8 months) from the original filing date within which they could have made the claims which, it is submitted, would be giving them the utmost limit of consideration.

It is, therefore, submitted that the Court of Appeals was correct in deciding this case by analogy with Section 4894 of the Statutes.

The Commissioner of Patents, however, totally ignoring the fact that Chapman & Chapman admitted a public use of more than six years before the filing of the divisional application, held that it was entitled to the same consideration as an original application and that the case should be decided by analogy with Section 4886 (two years public use or publication); that is to say, he argued as follows:

> "In the second place, an inventor after another has patented the invention may wait up to two years before filing his own application therefor (Revised Statutes, Sec. 4886) * * * * *
>
> No reason is seen why a stricter rule should be laid down to regulate the conduct of an inventor who has already filed his application at the time when a rival patent is granted than would be applied to one who filed after the rival patent was granted."
>
> (See Petitioner's Brief, page 7.)

This, it seems to Respondent, totally ignores not only the aggravated facts of this case, but also the effect of Section 4894 which lays down post-application diligence as one year and *presumes abandonment of the application* when no responsive amendment is made within the year from Office action. In other words, it would allow an applicant to take advantage of *pre-application* rules of diligence, when as an actual matter of fact, in order to have any standing at all, he must place reliance on the fact that he is *already in the Office with an application.* It is manifestly inconsistent for Chapman & Chapman to claim on the one hand the benefit of Patent Office rules relating to divisional applications, and on the other hand the benefit of *pre-application rules.*

Furthermore, the question arises how long can an applicant who has on file an application showing among others, but not claiming a specific invention, delay after the issue of a rival patent on the same invention in adding claims thereto before constructive abandonment of the application as to the particular invention takes place? It would seem that, since the public is put on notice as to the contents of all patents as they issue (*Boyden vs. Burke*, 14 How. 575-83), constructive abandonment in such cases would take place within one year by analogy to Section 4894, and here Chapman & Chapman's original application as to the particular invention would have become abandoned because of their failure to make any attempt to claim the particular invention until more than six years after their filing date and twenty months after Wintroath's patent issued.

To avoid this horn of the dilemma Chapman & Chapman would have to and do attempt to consider the divisional application as standing on its own merits, as though an original application, in which case Chapman & Chapman admittedly could not make the proper oath, as before pointed out.

The effect of the Commissioner's holding is that an applicant can at any time within two years after the issue of a rival patent, copy claims from the issued patent, even though he never before presented any claims to the particular invention, and this *no matter how long the applicant has been in the Office with his application.*

This constitutes a holding that there is no time limit within which claims may be added, which is in direct conflict with the decisions heretofore noted on pages 8-10 of this Brief, and opens the way to the very abuses so clearly pointed out therein.

It is true, indeed, as pointed out by the Commis-

sioner, an inventor may wait for two years before filing his *original* application, but where the application is a divisional one, an inventor has already undertaken to protect his invention and is presumed to have reduced it to completion, and the rule of diligence should obviously be more strict with respect to a completed invention, as compared with an invention as to which no presumption of completion arises, as is the case with all inventions previous to the filing of original application thereon. Otherwise it would be difficult to understand why Congress should distinguish between *pre*-application and *post*-application diligence, and require expedition in prosecution.

The inconsistency of the Commissioner's ruling is also emphasized by the fact that under Office Rule No. 96, the Office allows an applicant only 30 days within which to make claims suggested from a rival application for the purpose of an Interference, and if, after such notice the applicant fails to add the claims, his rights are forfeited. If 30 days' notice is sufficient to debar an applicant's right to make claims, when the Office gives notice why should it be insisted by the Commissioner that, where by operation of law, the public is put on notice of a patent at the time of issue, two years should be allowed? For the Rule, see Appendix.

In support of the two year rule of diligence, the Commissioner also made an analogy with the two year rule within which a reissue broadening the claims of a patent may ordinarily be obtained. The reissue rule, if it has any bearing at all, clearly supports Wintroath, for while *ordinarily* a delay of two years will not be treated as evidence of abandonment

Topliff vs. Topliff, 145 U. S. 156,

nevertheless, a much less length of time will be con-

sidered sufficient to debar the grant of the reissue where intervening rights have accrued.

See

Parker and Whipple Co. vs. Yale Clock Co., 123 U. S. 87.

Coon vs. Wilson, 113 U. S. 286.

Both of these cases were cited with approval in Topliff vs. Topliff, and in the first a delay of twenty (20) months and in the latter a delay of only three (3) months was held to constitute a bar to the grant.

In the present case, there are not only intervening rights but Chapman & Chapman had twenty months constructive notice thereof by operation of law.

Furthermore, if by analogy with the two year rule of Section 4886, an original applicant may delay within two years after the issue of a patent in copying claims for Interference purposes, then it would seem to be equally true that a patentee ought to be allowed to also wait two years after the issue of his patent to file a reissue application containing claims copied from a later issued patent for the purpose of an Interference. But in

Skinner vs. Carpenter, supra,

Carpenter had obtained a Patent, February 20, 1906; Skinner filed an application on July 1, 1907, on a feature shown but not claimed in Carpenter's patent, and made and sold the device, and informed Carpenter thereof; and two weeks after being thus informed, i. e. on August 9, 1907, Carpenter filed a reissue application with new claims dominating the Skinner device, and demanded an Interference with Skinner's application, which was granted.

Under the facts, however, it was held that Carpenter had lost his right by his delay to make the interfering claims. In reaching this conclusion the Court of Appeals, District of Columbia, followed *Top-*

liff vs. Topliff, and *Coon vs. Wilson, supra*, and *Farmer's Friend vs. Challenge*, 128 U. S. 506.

Chapman & Chapman also attempted to make an analogy with Section 4897 permitting the forfeiture of an application and its renewal within two years after the original allowance upon payment of the renewal fee. However, although the period of two years is provided by the Statute, it has been uniformly held that renewal must be promptly applied for and the applicant's right to renew are forfeited if another has in the meantime come into the field. See

Christensen vs. Noyes, supra,

in which it was held that although the filing of a renewal application within two years after allowance, entitled the applicant to his original application as a constructive reduction to practice he could not set up such reduction to practice, to defeat the patent of a subsequent applicant, so as to defeat his priority as the first inventor. In that case, Noyes renewed his application only two months after Christensen's later filed patent issued and nineteen months after the allowance of his original application.

It follows, therefore, that the treatment of renewal cases, as well as the treatment of reissues just considered, with respect to the matter of diligence, if anything, supports Wintroath's contention that a one year rule by analogy with Section 4894 should be controlling.

CHAPMAN & CHAPMAN NEVER "REGULARLY" PROSECUTING AN APPLICATION FOR THE INVENTION.

Fundamental Error Involved.

As to Chapman & Chapman's contention that they were regularly prosecuting an application in accord-

ance with the law and therefore following a legal remedy, in which no question of diligence short of that prescribed by Statute can arise, the answer is obvious. Claims are a necessary part of an application for patent; a drawing and a description are not of themselves sufficient to constitute an application. Can Chapman & Chapman be considered as "regularly" prosecuting an application for the patenting of an invention when they never presented any claims to the particular invention during a period of more than six years, but let that part of the application be dead in the Office for that period, apparently with no intention of ever seeking a patent thereon, until they see another in the field?

(In this connection, it is to be noted that the requirements for division made by the Patent Office (Rec. p. 42) did not relate to the specific subject matter in interference, but to other subject matter, so that the alleged divisional application is so far as it relates to the subject matter in issue is not a *bona fide* divisional application, filed in pursuance of an Office requirement for division.)

The fundamental error that lies back of the position taken by the Commissioner and by Chapman & Chapman arises out of a totally unwarranted practice which has been followed by the Patent Office without questioning for many years, namely the practice of permitting the filing of alleged divisional applications (even without a requirement for division on the part of the Patent Office) on features shown and described but not theretofore claimed in a pending application at any time during the pendency of the original application and regardless of the length of time it had been on file. This, led to the obviously mischievous practice of letting an application soak in the office for years

until the trade had independently developed the invention, when the applicant would come out with a divisional application and pounce upon the unfortunates who had proceeded to build up a business on the invention. These practices are clearly pointed out in the decisions discussed pages 9-10 of the Brief.

The practice of allowing the filing of such divisional applications arose out of the fact that it has in the past been considered, without any reservation whatsoever, that the mere showing and description of an invention along with others shown described and claimed, constituted a constructive reduction to practices of that invention.

That this is so, does not follow in all instances because the elements of good faith and diligence are essential prerequisites in the invitation extended by the patent system.

The Courts have even gone so far as to hold that the mere showing and describing of an invention in an application is *not* a constructive reduction to practice. See

Pittsburgh vs. Beler, 228 Fed. 674 (C. C. A. 3rd).

Saunder vs. Miller, 33 App. D. C. 456.

In Pittsburgh vs. Beler, Judge Buffington stated "No statute, decision or principle of the patent law is cited to us which in our view warrants the regarding the mere presence of a drawing in a patent application, lacking the essentials noted, as equivalent to a reduction to practice of the devise therein shown."

Similarly, in this case, there is no basis in Statute or authority for the proposition that the mere presence in a pending application of a feature never claimed is such a reduction to practice as will enable the applicant some six years later to file an alleged divisional

application directed to such feature for the purpose of defeating a prior patentee whose patent issued twenty months before the divisional application was filed, and of subjecting the public to an extension of the monopoly already granted at its expense upon the issue of such patent.

At the most in such a case as this, the applicant should be required to proceed within one year after another comes into the field and the analogy with Section 4894 is a sound one.

In conclusion, it is submitted that the Patent Statute cannot be accorded such a construction as would reward Chapman and Chapman's gross lack of diligence and very evident lack of good faith to the public, by the grant of another patent monopoly on a monopoly already running against the public for some years.

Respectfully submitted,

Paul Synnestvedt

for the Respondent.

APPENDIX.

Commissioner's Order #2,210, July 6, 1915:

After January 1, 1916, all applications which have been pending for more than three years or which have an effective filing date running more than three years shall be made special and any amendment or other action therein by or on behalf of the applicant which does not put the application in condition for allowance or final rejection shall be submitted to a Law Examiner for his approval of its entry.

Rules of Practice in the United States Patent Office—Rule #96:

Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner, when one of the applications is ready for allowance, shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignees, as well as to the attorney of record in each case. The parties to whom the claims are suggested will be required to make those claims and put the applications in condition for allowance within a specified time in order that an interference may be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to applicant whose application is in condition for allowance will not be delayed unless the time for making the claim

and putting the application in condition for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of that party will be held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner shall notify each of said principal parties and also the attorney of this fact.